FILED
APR 10 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

October Term 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

WILLIAM H. DAVIS
LOUIS BURGESS

104 GROSBY PRESS, INC., 80 Perry St., N. Y. C.—BEekman—3-2334-7-8

INDEX

PAGE

PETITION FOR WRIT OF CERTIORARI 1

Summary Statement of Matter Involved 2

The Questions Presented 7

Reasons Relied on for Allowance of the Writ 8

Prayer 9

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI 10

Opinions of the Court Below 10

Jurisdiction 10

Statement of the Case 10

Specification of Errors 10

Summary of Argument 11

The Court of Appeals has decided a federal question in a way probably in conflict with applicable decisions of this Court 14

The Court of Appeals has rendered a decision in conflict with decisions of other Circuit Courts of Appeals on the same matter and in conflict with decisions of the Court of Customs and Patent Appeals and of District Courts in other circuits 19

The Cases Referred to in the Opinion of the Second Circuit Court of Appeals 24

The Court of Appeals has found for the first time a bar to the grant of a patent for a new and useful invention in the secret use of the invention by the inventor partly for experimental purposes but predominantly for a commercial purpose more than one year prior to the filing of his application, and in so doing has far departed from the established rules of statutory interpretation as to call for an exercise of this Court's power of supervision 29

Table of Cases Cited

PAGES

Allinson Mfg. Co. v. Ideal Filter Co., 21 F. (2d) 22 (C. C. A. 8) 27, 28
American Whip Co. v. Hampden Whip Co., 4 Fed. 536 (C. C. D. Mass.) 8, 23
Andrews v. Hovey, 123 U. S. 267, 271, 274 14
Bryce Bros. Co. v. Seneca Glass Co., 140 Fed. 161 (C. C. N. D. West Va.) 8, 24
Egbert v. Lippmann, 104 U. S. 333 27
Electric etc. Co. v. Shimadzu, 307 U. S. 5 ..... 8, 17, 18
Hall v. Macneale, 107 U. S. 90 27
Jenner v. Bowen, 139 Fed. 556 (C. C. A. 6) 8, 19, 20
Kendall v. Winsor, 21 How. 322, 328-9 ... 8, 13, 14, 15, 27, 31
Macbeth-Evans etc. Co. v. General Electric, 246 Fed. 695 (C. C. A. 6) 8, 21, 22, 23, 27, 33
Manning v. Cape Ann etc. Co., 108 U. S. 462 ..... 8, 15, 16, 18, 20
National Aluminate Corporation v. Permutit, 145 F. (2d) 175, 180 (C. C. A. 6) 5
Paraffine Companies, Inc. v. McEverlast, Inc., 84 F. (2d) 335 (C. C. A. 9) 8, 20
Peerless etc. Co. v. Griffin etc. Co., 29 F. (2d) 646 (C. C. A. 2) 23, 29
Penn etc. Co. v. Conroy, 159 Fed. 943 (C. C. A. 3) .. 8, 19, 24
Pennock v. Dialogue, 2 Peters 1, 19 Fed. Cas. 171 (Case No. 10,491) 25, 26
Shaw v. Cooper, 17 Peters, 292, 322 27
Smith v. Sprague etc. Co., 123 U. S. 249 ..... 8, 16, 17, 20
Stresau v. Ipsen, 77 F. (2d) 937 (C. C. P. A.) 8, 23, 29

Statutes Cited

Section 31 (R.S. 4886) 3
Section 69 (R.S. 4920) 3

Supreme Court of the United States

OCTOBER TERM, 1945

No.

METALLIZING ENGINEERING CO. INC.,
Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Metallizing Engineering Co. Inc., prays that a writ of certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Second Circuit entered herein on the 10th day of January, 1946.

A certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals for the Second Circuit, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of Matter Involved

Petitioner sued respondents[1] in the United States District Court for the District of Connecticut for infringement of Reissue Patent No. 22,397 (933 B) issued to John F. Meduna, petitioner's assignor on November 30, 1943, on a process improvement in the metallizing art. The original patent 2,320,327 had been issued on May 25, 1943 upon application filed August 6, 1942.[2]

The District Court sustained the patent.

It held the patented process to be "a new and highly useful addition to the metallizing art" and patentable[3]; that it was not known or used by others or patented or described in any printed publication before Meduna's invention or discovery thereof;[4] and that it had not been in public use or on sale by others for more than one year prior to Meduna's application.[5]

---

[1] The defense was assumed by respondents' manufacturer, Metallizing Company of America, a competitor of petitioner (943 B; 85-87 C).

Note: We shall refer to the transcript of record by page number followed by the letter designating the volume, A, B or C.

[2] The reissue was necessitated by the inadvertent omission of drawings in the printing of the original patent 2,320,327, May 25, 1943; the original and reissue are in all other respects identical.

[3] 968-969 B; 62 Fed. Supp. 53-4.

[4] Findings 1-6, 942-948 B; 62 Fed. Supp. 43-45; Conclusions of Law 1, 968-971 B; 62 Fed. Supp. 53-54.

[5] Finding 7, 948-9 B; 62 Fed. Supp. 45-46; and Findings 15-18, 953-966 B; 62 Fed. Supp. 47-53. Conclusion 6, 980-981 B; 62 Fed. Supp. 58-59.

Respondents had pleaded invalidity, under Sections 31 and 69 of 35 U. S. Code (R.S. 4886 and 4920),[6] on the grounds (a) that the patented process had been in public use or on sale in this country for more than one year prior to the date of filing of the application by the inventor in his own machine shop, Meduna Machine Works;[7] and (b) that Meduna had perfected the process "several years prior to his filing" of the application and "between the date of such perfection * * * and the filing of such application," had used the invention in secret for profit with the deliberate purpose "of withholding disclosure of his in-

---

[6] Section 31 (R.S. 4886):

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 69 (R.S. 4920):

> "In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:
>
> * * * * *
>
> "Fifth: That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public."

[7] Supplemental Answer, par. 6(c), folio 23 at page 84, Volume A and Schedule A, page 11, folio 32.

vention and thereby enjoy exclusive rights thereto while maintaining said invention secret"; and that by reason thereof he "had abandoned his right to obtain a patent" for the invented process.[8]

The District Court rejected each of these defenses on carefully stated findings 8-13 inclusive (949-952 B; 62 Fed. Supp. 46-47), and Conclusions of Law 4 and 5 (974-980 B; 62 Fed. Supp. 56-58).

The facts found by the District Court are:

1. The inventor, owner of a small machine shop, first tried his process with results which seemed satisfactory in March of 1940. He filed his application on August 6, 1942. (Finding 8, 949-50 B; 62 Fed. Supp. 46).

2. Having been advised to test his process thoroughly in actual service before attempting to patent it, the inventor solicited orders for metallizing hardened metal parts and in the period from March 1940 to August 1941 (one year prior to his application date) received 66 orders which were processed for prices aggregating $1,100 representing about 10% of his gross business in that period (Finding 9, 950-51 B; 62 Fed. Supp. 46).

3. That at all times prior to August 6, 1941 the practice of the process was so guarded as not to come to public knowledge and that the nature of the process could not have been deduced from inspection or physical tests upon specimens of the processed product in the hands of the public (Finding 13, 952 B; 62 Fed. Supp. 47).

4. The inventor had a genuine experimental purpose in undertaking this secret practice of the process but as to a

---

[8] Supplemental Answer, par. 8, (9-10A).

part of it, at least, the experimental purpose was subordinate to a commercial purpose. (Conclusion 5, 979 B, fol. 2936; 62 Fed. Supp. 58; Findings 9-12, 950-952 B; 62 Fed. Supp. 46-7; Conclusion 3, 972-4; 62 Fed. Supp. 55-6).

5. The inventor's secret practice of the invention in the period prior to August 1941 was of wholly inadequate weight in the light of the circumstances to support a finding of an intent to abandon. (Conclusion 5, 979-80 B; 62 Fed. Supp. 58; Findings 9-13, 950-952 B; 62 Fed. Supp. 46-7).

On these facts the District Court held:

(1) that the defense of abandonment had not been sustained (Conclusion 5, 978-980 B; 62 Fed. Supp. 58).

> "For here it is apparent that from the time he stumbled upon his discovery the plaintiff sought jealously to preserve his patent rights. (Pars. 9 and 13) Although I have found that as to a part of his secret practice, at least, his experimental purpose was subordinate to a commercial purpose, the experimental purpose was nevertheless present and genuine.
>
> • • • • •
>
> "And while on the whole it seems clear that the invention had been reduced to practice by some time before August, 1941, his secret practice of the invention for the time intervening was of slight weight in itself, and of wholly inadequate weight in the light of the entire situation, to support a finding of an intent to abandon. National Aluminate Corporation v. Permutit, 6 Cir., 145 F. 2d 175, 180." (979 B; 62 Fed. Supp. 58)

(2) that the inventor's use, not being predominantly for experimental purposes, did not fall within the category

of experimental use or sale excepted from the statute by judicial decision (972-4 B; 62 Fed. Supp. 55-56); and

(3) that "a process invention which, as here, does not involve the use of an article invention may be practiced in secret, and the sale of its product will not be held to constitute a public use *of the invented process* if the plaintiff sustains the burden of proving that at the time the product is sold the process could not have been learned from the product. And that burden, as I have found (Par. 13), has been amply sustained by the plaintiff here." (987 B; 62 Fed. Supp. 57, italics in original.)

The Court of Appeals reversed the lower court on the ground that any use with a commercial purpose by the inventor, even though it was a secret use, beyond the statutory one year period limiting prior public use, forfeits the inventor's right to a patent. The public character of the use was rejected as the criterion; the sole test was made whether the use was for competitive gain; and the duration of the use for one year was held to be fatal even though the secret practice of the invention was found to be of wholly inadequate weight in the light of the circumstances to support a finding of an intent to abandon. The Court of Appeals said (287 C):

> "• • • it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting" except that he is "allowed to do so" for a limited period of one year by the statute, but "if he goes beyond that period of probation, he forfeits his right regardless of how little the public may have learned about the invention." • • •

"It is indeed true that an inventor may continue for more than a year to practice his invention for his private purposes or his own enjoyment and later patent it.[9] But that is, properly considered, not an exception to the doctrine, for he is not then making use of *his secret* to gain a competitive advantage over others." (Emphasis ours).

The Questions Presented

The questions petitioner seeks to have reviewed by this Court are:

1. Is the period of one year permissible under the statute (R.S. 4886) for public use after invention and before application for patent a fixed time limit upon the permissible duration of secret use of the invention by the inventor if that secret use is predominantly for a commercial purpose.

2. Does the limited use of an invention by the inventor in secret with a commercial purpose during any period of time, however short, more than one year prior to the filing of his patent application forfeit the inventor's right to a patent, when a present and genuine experimental purpose accompanied the commercial purpose; the inventor was at all times seeking jealously to preserve his patent rights; and his secret practice of the invention for the time more than one year before filing was of wholly inadequate weight in the light of the entire situation to support a finding of an intent to abandon.

---

[9] In the course of its opinion, the Court of Appeals also recognized that a prior secret use by a third person, other than the inventor, which did not disclose the invention to the art, does not constitute a statutory bar to the issuance of a valid patent (287 C).

Reasons Relied on for Allowance of the Writ

1. The Court of Appeals has decided a federal question in a way probably in conflict with applicable decisions of this Court.

Kendall v. *Winsor*, 21 How. 322;
Manning v. *Cape Ann etc. Co.*, 108 U. S. 462;
Smith etc Co. v. *Sprague*, 123 U. S. 249;
Electric etc. Co. v. *Shimadzu*, 307 U. S. 5.

2. The Court of Appeals has rendered a decision in conflict with decisions of other circuit courts of appeals, of the Court of Custom & Patent Appeals and of district courts in other circuits on the same matter

Jenner v. *Bowen* (C. C. A. 6) 139 Fed. 556;
Penn etc. Co. v. *Conroy* (C. C. A. 3) 159 Fed. 943;
Paraffine Companies, Inc. v. *McEverlast, Inc.* (C. C. A. 9) 84 F. 2d 335;
Macbeth-Evans Glass Co. v. *G. E. Co.* (C. C. A. 6), 246 Fed. 695;
Stresau v. *Ipsen* (C. C. P. A.) 77 F. 2d 937;
Am. Whip Co. v. *Hampden Whip Co.* (C. C., D. Mass. 4 Fed. 536);
Bryce Bros. Co. v. *Seneca Glass Co.* (C. C. N. D., West Va.) 140 Fed. 161.

3. The Court of Appeals has found for the first time a bar to the grant of a patent for a new and useful invention in the secret use of the invention by the inventor partly for experimental purposes but predominantly for a commercial purpose more than one year prior to the filing of his application, and in so doing has so far departed from the established rules of statutory interpretation as to call for an exercise of this Court's power of supervision.

PRAYER

WHEREFORE your petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court and that your petitioner may have such other and further relief in the premises as to this Court may seem meet and just.

Respectfully submitted,

WILLIAM H. DAVIS,
LOUIS BURGESS,
Attorneys for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the District of Connecticut is reported in 62 Fed. Supp. 42-65.

The opinion of the Circuit Court of Appeals for the Second Circuit appears at pages 281 *et seq.* in Volume C of the transcript of record.

Jurisdiction

Jurisdiction of this Court is invoked under Section 240a of the Judicial Code as amended by the Act of February 13, 1935 (28 U. S. C. Section 347). The judgment of the Circuit Court of Appeals for the Second Circuit which petitioner seeks to have reviewed was entered January 10, 1946 (288C).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors

The error which petitioner will urge if the writ of certiorari is issued is that the Circuit Court of Appeals for the Second Circuit erred:

In holding that the practice of the patented process by the inventor in secret with a commercial purpose more

than one year prior to the date of application for the patent effected a forfeiture of the inventor's right to the patent, thus rendering the patent invalid; and in dismissing the complaint.

Summary of Argument

The points of the argument will follow the reasons relied on for the allowance of the writ. We desire, however, at this point, to say that we find it very difficult, after most careful analysis of the opinion of the Second Circuit Court of Appeals, to make any clear statement, with reference to the statute, of the ground upon which the Court rested its denial of the inventor's right to a valid patent.

The defenses pleaded under the statute (R.S. 4886 and 4920) were (1) prior public use and (2) abandonment.* The trial court made findings of fact which preclude abandonment, and concluded that the defense of abandonment had not been sustained. The Circuit Court of Appeals accepted these findings and clearly stated that its decision did not rest on abandonment. Thus, speaking of the forfeiture which it found in the inventor's secret use of his process more than one year prior to his application with a commercial purpose, which it characterized as "competitive exploitation • • • of his process", the Court said (287 A):

> "Such a forfeiture has nothing to do with abandonment, which presupposes a deliberate, though not necessarily an express, surrender of any right to a patent".

---

* 8 A, folio 23 and 9-10 A, par. 8, of the Supplemental Answer.

As to the pleaded defense of public use, the trial court expressly found that the use was not public but secret, so that there had been no contribution to the art by the inventor or anyone else of knowledge of the process, and the Court of Appeals accepted that finding.

Defendant having thus failed, as to each of the two defenses (abandonment and prior public use), to prove the supporting facts pleaded, the District Court gave judgment for plaintiff. The Court of Appeals, although it accepted the District Court's findings of fact, reversed the judgment because the secret use by the inventor with commercial purpose continued more than one year before the application was filed.* Although the opinion of the Court of Appeals clearly says that the reversal was not on the ground of abandonment, nowhere does it expressly say whether its decision rests on the ground of prior public use. There is much in the opinion to indicate that the Court felt that the statutory provision as to prior *public* use could and should be interpreted to include a prior *secret* use by the inventor with commercial purpose, but no express statement to that effect.

We prefer, however, not to obscure our discussion of the need for exercise of this Court's power of supervision in this case by trying to say whether the Circuit Court of Appeals intended to rest its decision on the "public use" section of the statute or on what seemed to it sound considerations outside of and beyond those statutory bars which the statute expressly erects.

---

* It should be noted that the pleading of prior secret use did not include any averment that the secret use had been for more than one year before the application was filed, or any allegation of forfeiture on that ground (Supplemental Answer, par. 8, 9-10 A).

The nub of the matter is fairly presented, we believe, by saying that the Circuit Court of Appeals has found that a patentee forfeits his right to an otherwise valid patent, if he secretly uses the invention in commercial competition and allows that secret use to continue more than one year before he files his application. The one-year period was certainly derived by the Court from the statute, and the asserted forfeiture is of like character with the statutory forfeiture which occurs when the patentee puts off filing his application more than one year after it has been patented or described in any printed publication in this or any foreign country or has been in public use or on sale in this country; a forfeiture which results invariably from the passage of time, whether the prior patenting or publication or prior public use was by the inventor or someone else and without regard to any other conduct or intention of the inventor or any circumstances whatever other than the mere lapse of time.

We have not found in this Court any case in which such a forfeiture of the right to an otherwise valid patent has been asserted in that form or discussed from that point of view. There is, however, at least one case in this Court (*Kendall* v. *Winsor*, 21 How. 329), in which the patent was sustained in spite of the existence of all the factual conditions upon which the Circuit Court of Appeals rested its decision, thus presenting a direct conflict. There are several other cases in which the non-existence of that rule of forfeiture is necessarily implied by the decisions of this Court. And there are similar cases of direct conflict and of conflict by necessary implication with other Circuit Courts of Appeals, with District Court decisions and with the Court of Customs and Patent Appeals.

Furthermore, there are decisions of this Court which preclude the idea that forfeiture by secret use can be predicated on the "public use" provision of the statute.

The Court of Appeals has decided a federal question in a way probably in conflict with applicable decisions of this Court.

In *Kendall* v. *Winsor,* 21 How. 322 (1858), the patent was for a machine for making harness. The inventor built one machine in 1846 and four in 1849 and filed his application in November 1854. During this period from 1846 to 1854 he took precautions to keep his machine secret but he sold the harness made by the machine on all orders he obtained (p. 324).*

The applicable statute then in force, Section 7 of the Act of 1839, contained provisions similar to those of the present statute. It made public use more than two years prior to the application a bar to patenting.** It also made abandonment a defense.

There was some suggestion that the inventor's use of the invention for a period of nearly eight years prior to his application was experimental but the district court refused to charge on this subject and treated the case as one

---

* The Second Circuit Court of Appeals recognized (285A) that the facts in the *Kendall* case "presented the same situation as here" but believed "the case adds nothing" because it erroneously thought that "The jury brought in a verdict for the defendant." The fact is the "jury found a verdict for plaintiff" (21 How. 322).

** See *Andrews* v. *Hovey,* 123 U. S. 267, 271, 274, interpreting this statute. The word "public" was not actually in the statute but the word "use" was always interpreted to mean public use. *Andrews* v. *Hovey, idem.*

of the use of a completed machine (p. 325-7). It is plain that if the inventor's secret use of his machine for more than two years prior to application accompanied by sales of its product constituted the invariable forfeiture now found by the Second Circuit Court of Appeals the case would have ended then and there in a directed verdict for defendant. The trial Judge charged the jury, however, that in order to constitute abandonment "in a case where it did not appear any sale of the *thing patented* had been made, and there was no open public exhibition of the machine" an actual intent to relinquish the right to a patent must be found (p. 327).

This court emphasized that abandonment involves "an inquiry or conclusion of fact • • • peculiarly within the province of the jury" and approved the instruction of the trial court saying (p. 331):

> "• • • we consider that instruction to be in strict conformity with the principles hereinbefore propounded, and with the doctrines of this court, as declared in the cases of Pennock v. Dialogue and Shaw v. Cooper."

Thus the decsion of this court in *Kendall* v. *Winsor* in 1858 is in direct conflict with the decision of the Second Circuit Court of Appeals in the case now sought to be reviewed. All of the facts which make up the forfeiture found by the Court of Appeals in the instant case, and which led it to hold the patent invalid, were present in the *Kendall* v. *Winsor* case, yet this court approved instructions of the trial court which resulted in a holding of validity.

The next case of apparent conflict in this court is *Manning* v. *Cape Ann etc. Co.* 108 U. S. 462 (1882). In this

case the patent was for a process of making isinglass which involved the use of a machine of known design. The inventor, Manning and his partner Norwood used the process commercially in competition for profit in their business of manufacturing isinglass from 1860 to 1867. They then separated, Norwood retaining the machine and continuing a like use of the process until 1870. Manning established his sons in partnership and they also used the process commercially from 1868 to 1873. The patent was applied for in 1873.

It was claimed that the use of the process "was a secret and not a public use". But this court upon examination of the evidence, concluded that the use of the process was "open to the public generally". It also pointed out that Norwood after the dissolution of the partnership was "allowed * * * the unrestricted use of the patent * * *, without injunction of secrecy or other condition. This is sufficient to constitute a public use" (p. 465).

If the rule of forfeiture adopted by the Second Circuit Court of Appeals in the instant case had existed, that would have disposed of the case without regard to any question as to whether the use of the patented process was public or secret, for the use was admittedly commercial and for over two years prior to the filing of the application. The fact that this court found it necessary to examine the evidence and resolve the issue as to whether the use of the process was secret or public and to base its decision on the resolution of that issue denies the existence of the invariable rule of forfeiture adopted by the Second Circuit Court of Appeals in the instant case.

The next case is *Smith, etc. Co.* v. *Sprague,* 123 U. S. 249 (1887). The patent was for a machine for making shoe

buckles. The inventor had used the machine in his factory and had sold large quantities of buckles more than two years prior to his application. This court held the use a public use saying: "It was a public use in the sense of the statute and within the decisions of this court, inasmuch as it was used by the complainant in the regular conduct of his business by workmen employed by him in its operation, and in the view of such part of the public as chose to resort to his establishment, either for the purpose of selling material for the manufacture or of purchasing its product" (p. 254). And in reviewing the evidence the court referred to testimony establishing that no attempt was made to keep the operation of the machine secret from all comers (p. 260).

The decision of this court in *Smith, etc. Co.* v. *Sprague* is, therefore, like its decision in the *Manning* case just discussed, one which presents by necessary implication a conflict with the decision of the Second Circuit Court of Appeals in the instant case.

The fourth case is *Electric Battery Co.* v. *Shimadzu*, 307 U. S. 5 (1938). In this case the defense of prior public use by defendant was raised against two of the patents in suit which claimed a process and a machine for producing lead oxide and the product of that process. Defendant had used plaintiff's process and machine for the production of lead oxide used in the manufacture of storage batteries which were sold in quantity more than two years prior to the application date (p. 20). This court was, therefore, confronted by the question whether this "commercial use * * * is, in contemplation of law, a public use within the meaning of R.S. 4886" (p. 19). The court said:

> "A mere experimental use is not the public use defined by the Act, but a single use for profit, *not purposely hidden,* is such." (p. 20) (emphasis ours)

In discussing the evidence the court pointed out

> "There is no finding, and we think none would have been justified, to the effect that the machine, process, and product were not well known to the employees in the plant, or that efforts were made to conceal them from anyone who had a legitimate interest in understanding them." (p. 20)

Thus this court again made the test of public use whether the patented process and machine were in fact used in public. The fact that defendant used the process and machine commercially and the product was sold competitively was not determinative of the issue of public use although it excluded the suggestion of experimental use.

If the decision of the Second Circuit Court of Appeals here sought to be reviewed is predicated on the "public use" provision of the statute, then it is in conflict with the decision of this court in this *Shimadzu* case, which precludes the idea that forfeiture by secret use can be predicated on the public use provision of the statute. The statutory provision as to public use makes no distinction as to whether the use that made the invention available to the public was by the inventor or by a person other than the inventor. This court in applying the public use provision of the statute has always treated use by the inventor and use by others than the inventor alike. See, for instance, the *Manning* case, 108 U. S. 462, *supra.*

The Court of Appeals has rendered a decision in conflict with decisions of other Circuit Courts of Appeals on the same matter and in conflict with decisions of the Court of Customs and Patent Appeals and of District Courts in other circuits.

In *Penn etc. Co.* v. *Conroy* (C. C. A. 3) 159 Fed. 943 the patent was for a machine for ornamenting glass. The machine was used secretly by the inventor in his factory and the product of the machine was sold commercially more than two years prior to the application. The defense of public use was rejected on two grounds: (1) that the use was experimental; and (2) that the use "was not public within the meaning of the statute" (p. 946), because the use of the machine was in secret and "whatever knowledge, if any, was obtained of the machine by the public, was surreptitious and contrary to the manifest wish and intention of the inventor" (pp. 946-7). This second ground of decision is in direct conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Jenner* v. *Bowen* (C. C. A. 6) 139 Fed. 556 the patent was for a machine for making bottle wrappers. The inventor assigned to Bowen the exclusive right to make and sell an "improved paper bottle wrapper". No patent was obtained for the wrapper but the inventor designed and built the machine of the patent for Bowen at an agreed price. Bowen agreed to pay royalties and the inventor's livelihood depended on the income derived from the use of the machine and the sale of the bottle wrappers. This commercial use of the machine went on for more than two years prior to the filing of the application. The only defense considered by the Court of Appeals in that case was

that the patented invention was in public use for more than two years prior to the date of the application for a patent. The Court examined the evidence and found that the machine was readily accessible and that the employees of the owners were under no obligation of secrecy. It held the use to be a public use.

In this *Jenner* case, as in the *Manning* case and in the *Smith* v. *Sprague* case in this court (*ante*, pp. 15-17), the whole inquiry as to the public character of the use of the machine would have been unnecessary if the sale of the product of the machine prior to the two year period automatically barred the patent. The decision is therefore by necessary implication in conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Paraffine Companies, Inc.* v. *McEverlast, Inc.* (C. C. A. 9) 84 F. 2d 335 the patent was for a machine for wrapping pipe. A similar machine had been used by a stranger to the inventor more than two years prior to the application and the wrapped pipe had been sold in large quantities. On the question of public use, the court noted the difference between the sale of the patented thing to the public and the use of it to produce goods to be sold and conceived the issue to be whether the use of the machine was concealed from the public (p. 340). Finding that there was not the slightest evidence that the machine was kept secret, it held the use of the machine to be a public use. (p. 341)

This case, like the *Shimadzu* case in this Court, is in conflict with the decision of the Second Circuit Court of Appeals in the instant case if that decision is predicated on the "public use" provision of the statute.

In *Macbeth-Evans etc. Co.* v. *General Electric Co.*, (C. C. A. 6) 246 Fed. 695, the patentee had used his process secretly for making glass commercially for over nine years before his application. The court held, on the authority of *Pennock* v. *Dialogue* and *Kendall* v. *Winsor*, that the right to a patent had been abandoned. On the facts presented the court found that there was an intent to delay indefinitely application for patent protection while resorting to secrecy to give an effective monopoly in the meantime.

In the District Court the facts were presented on stipulation and the court (Clark, District Judge, 231 Fed. 183, 184) said that the stipulated facts presented two questions (1) abandonment; and (2) prior public use. In the course of his opinion Judge Clark (afterwards Justice Clark) discusses at length the question whether "a use designed to be kept secret may not be a public use" under the statute (188-9). He sustained the defense pleaded which was that "by the course of action described and admitted, the plaintiff and Macbeth forfeited any right to a patent" (184).

The Court of Appeals expressly put aside that portion of the District Court's decision which dealt with the question of public use, and limited its consideration to questions pertinent to abandonment, saying (246 Fed. 698):

> "It is not necessary, we may observe, to consider the portion of the decision below which deals with the question of public use. Our consideration will be limited to questions pertinent to abandonment."

The court went on to say that if the process and the product are distinct things "there are some difficulties in

the way of concluding that secret use of the process resulting in public use and sale of the product constitutes the statutory public use of the invention", and it therefore passed the question, basing its decision wholly on abandonment.

It is clear that if the rule of forfeiture found by the Second Circuit Court of Appeals in the instant case had been known to these experienced judges in the Sixth Circuit, they would have had no occasion to struggle with either one of the questions which they disposed of in the *Macbeth-Evans* case. The facts there stipulated show secret use by the inventor with a commercial purpose for more than two years prior to the application, thus presenting without question all of the facts which were found by the Second Circuit Court of Appeals to create the forfeiture, apart from any other considerations whatever.

Indeed, we think it is also clear from Judge Warrington's opinion that, if the supposed rule of forfeiture found by the Second Circuit Court of Appeals had been suggested to the Sixth Circuit judges in the *Macbeth-Evans* case, it would have been rejected for the reason that the statute does not in terms provide for such a forfeiture and Congress did not intend to prescribe a distinct period within which a patent must be applied for after an invention is perfected, except in the case of prior patenting or publication or prior public use. Judge Warrington said (702):

> "When the intent then of sections 4886 and 4920, paragraph 5, is kept in mind, they may be as literally interpreted as counsel claim they must be, and yet forbid issue of the patent in suit. The views thus expressed are fortified by the rule that *abandonment may take place at any time.* Elizabeth v.

> Pavement Co., 97 U. S. 126, 134, 24 L. Ed. 1000. That rule differs *and ought to differ* from the statutory rule enacted with reference to the public use of an invention or the act of placing it on sale, since abandonment in itself signifies surrender of the right to a patent. *This would seem to indicate a strong reason, if not the very reason, for the omission to prescribe a distinct period* within which a patent must be applied for after an invention is perfected." (Emphasis ours)*

Finally, as the opinion of the Second Circuit Court of Appeals points out, its decision in the instant case is a direct reversal of its earlier decision in *Peerless etc. Co.* v. *Griffin etc. Co.*, 29 F. 2d, 646 (1928); and is also directly in conflict with the rule established in the Court of Customs and Patent Appeals by the decision of that court in *Stresau* v. *Ipsen*, 77 F. 2d, 937 (1935).

In the District Courts we find two cases in other circuits which are in conflict with the decision of the Second Circuit Court of Appeals in the instant case. They appear to be the only decisions on the subject in those circuits and may be presumed to represent the now prevailing doctrine in those circuits, the First and Fourth.

The first is *Am. Whip Co.* v. *Hampden Whip Co.* (C. C., D. Mass.) 4 Fed. 536 where the patent was for a method of constructing a whipstock. The method was used for making whipstocks which were sold more than two years prior

---

* Bills having the aim of inducing filing within a restricted period after the invention is made, by limiting the inventor's proof of priority to a specified period before the application, have been proposed and Congress has not seen fit to adopt them. See H.R. 10156 and H.R. 11019, 72nd Congress.

to application. The patent was sustained because "neither the invention, nor anything which embodies or would be likely to suggest it, is found in the completed whip" (p. 538). The case is therefore in direct conflict with the decision of the Second Circuit Court of Appeals in the instant case.

In *Bryce Bros. Co.* v. *Seneca Glass Co.* (C. C., N. D. West Va.) 140 Fed. 161 the patent was for a machine for engraving glassware. The machine was secretly used in the factory of the inventor's employer and the etched glassware was sold more than two years prior to the application. The defense of public use was rejected on two grounds: (1) because the use of the machine was experimental and (2) because the secret use of the machine was not a public use even though the product of the machine was sold (p. 174). On the second ground of decision, the case presents the same direct conflict with the decision of the Second Circuit Court of Appeals as does the decision of the Third Circuit Court of Appeals in *Penn etc. Co.* v. *Conroy* (*ante*, p. 19).

The Cases Referred to in the Opinion of the Second Circuit Court of Appeals

The difficulty we have found to satisfactorily analyze the ground upon which the Circuit Court of Appeals rested its decision in the instant case is enhanced by the fact that upon examination it appears that in particularly important ways the substance and effect of the cases referred to in that opinion are not correctly stated therein. Despite the superficial suggestion to the contrary that might well be derived from the opinion, the cases referred to therein do

not at all support the conclusion reached by the Court of Appeals nor do they contain any statement of doctrine from which that conclusion could be deduced.

It is said in the Court of Appeals' opinion (284 C) that in *Pennock* v. *Dialogue*, 2 Peters 1, the patent was "for a process of making hose" and that it "did not appear that the joints in any way disclosed the process". Although the opinion does not further elaborate this statement, it plainly suggests that in the *Pennock* case, as in the present case, there was a secret use with a commercial purpose. The fact is that in the *Pennock* case the patent was not for a process but for a hose structure in which the sections were joined together in a certain way. The sale of the hose was a sale of the thing patented and was therefore truly a public use. This appears clearly in the charge of the trial court* and is implicit in the opinion of this court which is studded with references to "the thing invented". The final conclusion of this court was that an inventor loses his right to a patent under the statute then in force "if he suffers the *thing invented* to go into public use, or to be publicly sold for use" before his application (pp. 23-4; emphasis ours). As a matter of decision, the *Pennock* case is therefore not in point on any question arising from secret use. The opinion of the Second Circuit Court of Appeals quotes a part of the famous statement in the *Pennock* case in which this Court adverted to the

---

* 19 Fed. Cas. 171 (Case No. 10,491). In speaking of a prior hose, the Court charged that it was for the jury to say whether it is "in form, structure, or principle, the same thing as the hose for which this patent was granted" (p. 173). And again the Court charged "the hose invented by Mr. Bedford more nearly resembles that which the plaintiffs have patented" (p. 173). In similar vein

basic conflict between the power of an inventor to hold back from the knowledge of the public the secrets of his invention and the purpose of the patent law to promote the progress of science and useful arts, but this court in the *Pennock* case resolved that conflict only to the extent of holding that the statute, which then provided only that the invention patented had to be one "not known or used before the application", must be construed to mean that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use or to be publicly sold for use, before he makes his application for a patent, saying (p. 24):

> "His voluntary act or acquiescence in the *public* sale and use is an abandonment of his right; or rather creates a disability to comply with the terms and conditions on which alone the secretary of state is authorized to grant him a patent." (emphasis ours)

The opinion of the Court of Appeals in the instant case then refers to a similar statement of a basic policy by this

---

the Court put it to the jury, to say "whether the hose described by Anderson, and that patented, are the same in principle" (p. 174). In charging on the question of abandonment the Court referred to the hose as "the article so publicly used, and afterwards patented" (p. 174). See also defendant's argument in this Court where counsel said the "averment * * * on which they obtained their patent was, that the rivet hose was a new invention" (2 Peters 8).

The author of the opinion in the instant case was perhaps misled by a statement in the opening of the opinion of this court in *Pennock* v. *Dialogue* that the patent was for an "improvement in the art of making leather tubes or hose" (p. 14). Taken alone, this might indeed support the conclusion of the Court below. But in the light of the positive evidence that the thing patented was the hose, the language can only be interpreted as a loose but not uncommon way of referring to an improvement in an article, which is frequently spoken of as a new way of making the article.

court in *Shaw* v. *Cooper*, 7 Peters 292, 322. That case also was a case of public use of the thing invented *and later patented*. The issue decided was whether the use had been with the inventor's consent.

Then the opinion of the Court of Appeals refers to the decision of this court in *Kendall* v. *Winsor*, quoting a similar general statement of policy from that decision on page 328. The opinion correctly states (285 A) that in the *Kendall* case "the facts presented the same situation as here"; but the Court mistakenly believed that "the jury brought in a verdict for the defendant on the issue of abandonment". The fact is that the "jury found a verdict for plaintiff" (21 How. 322) and this court expressly approved the instruction of the trial court preceding that verdict. Thus, as we have pointed out, the decision of this court in *Kendall* v. *Winsor* was in direct conflict with the decision of the Second Circuit Court of Appeals.

The cases of *Egbert* v. *Lippmann*, 104 U. S. 333 and *Hall* v. *Macneale*, 107 U. S. 90, next referred to in the opinion, both involved a public use of the things patented, an article of commerce.

The first Court of Appeals case referred to in the opinion of the Second Circuit Court of Appeals is *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 Fed. 695 (C. C. A. 6). We have already discussed that case (*ante*, pp. 21-2) and have pointed out how erroneously the Second Circuit Court of Appeals interpreted Judge Warrington's remark on page 702.

The second Court of Appeals case relied on in the opinion below is *Allinson Mfg. Co.* v. *Ideal Filter Co.* (C. C. A. 8) 21 F. (2d) 22. The opinion states the facts in that case to be

> "the patent was for a machine for purifying gasoline; the machine was kept secret, but the gasoline had been sold for a period of six years before the application was filed."

This is incorrect. The machine was used by the inventor in his own cleaning establishment to clarify "his gasoline" (p. 24). He was not clarifying gasoline for sale but for his own use. He did sell his gasoline when he sold his business in 1916 but this was clarified by a machine from which his patented improvement had been removed (p. 24). From 1916 on he did nothing with his invention, until he saw a rival machine on the market in 1920. This revived his interest and led him to file this application. The court held that under the circumstances of the case the inventor had abandoned his right to a patent. This ground of decision is correctly stated in the opinion below but the opinion adds: "We are disposed however to read the latter part—pages 27 and 28—as holding that the sale of gasoline was a 'prior use' *of the machine,* notwithstanding its concealment." (Emphasis ours) This interpretation cannot be justified. Apart from the fact that no gasoline was sold and no reference to the sale of gasoline is made in the part of the opinion referred to, the opinion bases its finding of "public use" on the ground that the machine itself was "in plain view" of "at least three employes" who were under no injunction of secrecy (p. 27). The ground of the decision was that there was in fact no "concealment" of the machine. This case therefore affords no support for the rule adopted here. Indeed the case negatives the existence of such a rule for its opinion points out that abandonment is not tied to any statutory time period but is left "at large on facts to be established" (p. 23).

The remainder of the discussion of decided cases in the opinion of the Second Circuit Court of Appeals deals with the decisions of the Court of Customs and Patent Appeals in *Stresau* v. *Ipsen,* 77 Fed. 2d, 937, and with the Second Circuit Court of Appeals' own decisions, particularly *Peerless Roll Leaf Co.* v. *Griffin & Sons,* 29 F. 2d, 646. As we have seen, the opinion recognizes that the *Stresau* case in the Court of Customs and Patent Appeals is directly in conflict, and that the court's decision in the instant case is an express reversal of its earlier decision in the *Peerless* case.

The Court of Appeals has found for the first time a bar to the grant of a patent for a new and useful invention in the secret use of the invention by the inventor partly for experimental purposes but predominantly for a commercial purpose more than one year prior to the filing of his application, and in so doing has far departed from the established rules of statutory interpretation as to call for an exercise of this Court's power of supervision.

The conditions under which a valid patent may be granted are wholly determined by Congressional enactment under Article 1, Section 8, of the Constitution. It is our submission that the Congress by a progressive series of enactments in the light of practical experience has developed a mature and comprehensive plan for reconciling the basic conflict between the power of an inventor to withhold his invention from the public and the constitutional purpose to promote the progress of science and useful arts.

We think those statutory provisions present no need, and leave no room, for the creation of any new limitation

upon the right to a patent by special judicially created rules for particular situations. We think any such new rule should be created only by the Congress where the pros and cons can be submitted to the judgment of the legislators. But if we are wrong in that, we submit that, in the interest of orderly and uniform administration of the patent statutes, the new bar to the grant of a valid patent established by the decision of the Second Circuit Court of Appeals in the instant case should not be allowed to stand unless and until the pros and cons have been presented to and considered by this court.

Aiming to induce prompt filing of a patent application when the inventor is engaging in secret use of his invention for profit, the decision below requires that the application be filed within a year from such a use if the patent is to be valid. But in the light of experience and observation including this very situation and other situations making the prompt filing of patent applications desirable in the public interest, Congress has already created simple and comprehensive statutory provisions to induce promptitude in filing applications. These statutory provisions, deemed by Congress to be adequate and to be a fair reconcilement of the public and private interests involved, leave no room for special judicially created rules for particular situations.

The public interest is affected in two ways by any delay in filing a patent application. First, it postpones the day when the public will come into the free enjoyment of the invention at the end of the patent term; and second, the total period of monopoly is prolonged to the extent that the inventor protects himself by secrecy before filing his ap-

plication. There is no question here as to the reality of this public interest. If nothing else were involved, this public interest would call for a statutory requirement that the inventor file his application at once after making his invention, with only enough time allowed to prepare the application. The problem has always been, however, to reconcile this public interest with the interest, shared alike by the inventor and the public, in allowing some period for "completing an invention, or for a test of its value or success by a series of sufficient and practical experiments" (*Kendall* v. *Winsor*, 21 How. 322, 328-9).

The history of this problem with its conflicting interests has been one of interplay between the courts and Congress. The early statute was quite inadequate, and its inadequacy became apparent as the early cases in the courts brought up the conflict of interest under different fact situations. It would be an undue burden here to trace the whole course of the statutory development. It is enough to say that the early tendency of the courts, understandably enough, was to deal with the problem by a judgment in each case under general criteria reflecting the opposing interests and a general desire to reach a reasonable result under all the circumstances of each case. The course of legislation was different and it supplanted the judicial mode of treatment. Congress elected to deal with part of the problem by a simple and arbitrary formula without attempt at distinction among different fact situations. The culmination of this was the provision as to prior patenting or publication or prior public use in the statute of 1870, which is the present statute in all essentials of mode of treatment with a difference only in the change of the period of grace from two years to one year.

So far as it is pertinent here, this statute (R.S. 4886) which governs the grant of patents contains two conditions which have the purpose and effect of causing inventors to apply for patent promptly, while also providing for the necessary time for completion of the invention and sufficient practical tests of its value:

1. Regardless of when he made the invention, the inventor is barred if any of several events occur more than a year before the filing of his application, namely: public use or sale of the invention in the United States by anyone, the inventor or anyone else; or a patenting of it or a description of it in a printed publication anywhere by anyone, unless the patenting was by the same inventor on an application filed in a foreign country within a year before his application in this country (R.S. 4887).

2. The inventor is barred also if he has abandoned the invention, whether within or prior to the year preceding his application.

The first group of statutory bars is characterized by their arbitrary and automatic effect. No account is taken of the circumstances or of the purpose or intent of the inventor in delaying the filing of his application. Congress has dealt with the matter on a broad basis, fixing an arbitrary and invariable time limit which has to justify itself in its operation on the average, not in the particular case.

The relation of this set of statutory conditions to the public interest in early filing is plain and direct. An inventor is put under a powerful stimulus to file within a year after he makes his invention, for if he delays longer he runs the risk that some public use or sale, or patent, or

printed publication, of which he may have no real means of notice will arise to bar his patent.

The further condition of the statute, that the invention must not have been abandoned, gives further protection of the public interest. It applies, without any year of grace, alike to the case of abandonment by non-use and that of secret use. The decision in *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 Fed. 695, illustrates the effectiveness of this statutory condition to embrace the situation of an inventor who elects to rely on secrecy for protection and then resorts to patenting when secrecy fails. The significant fact about this abandonment provision is that it has no arbitrary time limit but leaves the question for decision on all the facts of the particular case.

The Second Circuit Court of Appeals in the instant case did not discuss the matter in relation to this statutory method of dealing with the problem of inducing early filing. Whether because it thought it inadequate or because it did not note its existence, the court supplemented it by its new requirement that for a valid patent the application must be filed within a year from a secret use by the inventor, when that use had a commercial purpose (profit) along with its experimental purpose.

The question here is not whether this legislative system is ideal. Some might well think it better to deal with each category of the problem by a provision aimed at nicer justice. The fact is that Congress has dealt with the whole problem on an informed basis and whatever it has deemed adequate to protect the public interest in question should, we submit, be accepted as final and complete until Congress changes it. At any rate, we must respectfully urge upon

this court that such a change, of general significance, as the Second Circuit Court of Appeals has made in the provisions of the patent law as heretofore understood and applied, should now be reviewed by this court, in the interest of an orderly and uniform administration of the patent statutes.

WILLIAM H. DAVIS,
LOUIS BURGESS.

17

FILED
APR 27 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

MORRIS KIRSCHSTEIN,
CLIFFORD H. BELL,
of Counsel for Respondents.

INDEX

PAGE

Statement 1

I This Court has already definitely refused to grant *certiorari* to review the identical question in *Macbeth-Evans Glass Company* v. *General Electric Company* (246 U. S. 659), No. 821 October Term, 1917) 3

II The decision of the Court of Appeals in the present case is in harmony with the decisions of this Court, the Circuit Courts of Appeals and the District Courts. No novel question of patent law is presented 4

TABLE OF CASES CITED

Allinson Mfg. Co. v. Ideal Filter Co., 21 Fed. (2d) 22 (CCA 8) 7

Egbert v. Lippmann, 104 U. S. 333 ..... 6, 8, 9

Electric Storage Battery Co. v. Shimadzu, 307 U. S. 5 .. 9

Elizabeth v. Pavement Co., 97 U. S. 126 9

Grasselli Chemical Co. v. National Aniline Co., 26 Fed. (2d) 305 (CCA 2) 7

Hall v. Macneale, 107 U. S. 90 ..... 7, 9

Kendall v. Winsor, 21 Howard 322 10

Macbeth-Evans Glass Company v. General Electric Company, 246 U. S. 659 ..... 3, 8

Macbeth-Evans Glass Company v. General Electric Company, 246 Fed. 695 (CCA 6) 8

Macbeth-Evans Glass Company v. General Electric Company, 231 Fed. 183 (D. C.) 8

Pennock and Sellers v. Dialogue, 2 Peters 1 ..... 4, 5, 6, 8

Woodbridge v. United States, 263 U. S. 50 ..... 6, 9, 10

STATUTE CITED

35 U. S. Code Sec. 31 (R. S. 4886) 5

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI

The petition does not present a case of conflict between Circuit Courts of Appeals; nor is it predicated upon a question of public interest. No novel question of patent law is involved.

Statement

This case is merely an ordinary patent suit in which petitioner charges respondents with infringement of the Meduna Reissue patent No. 22,397. The District Court held the patent valid and infringed. The Court of Appeals for the Second Circuit reversed, holding the patent invalid on the ground that the inventor had forfeited his right to a patent because he had made public use of the invention for profit for more than one year prior to filing of his application. This statutory bar had been pleaded and overruled in the District Court. The Circuit Court of Appeals found the bar to have been established. The

defense of lack of invention had also been pleaded and overruled in the District Court. This defense too was presented for review to the Circuit Court of Appeals but that Court did not pass on that issue.

The patent is for a process of building up worn metal parts of a machine by spraying the worn part with molten metal. This is known as "metallizing" and the process as thus generally described is old. In accordance with the invention the part to be sprayed, for example, a crank shaft of an automobile, is first roughened by electrically depositing on its surface a rough layer of metal. This layer serves as the anchoring or bonding means for receiving and holding the molten metal spray which is applied to the surface by means of a spray gun in similar fashion to the spraying of paint or other coatings on surfaces. The spraying proceeds until a sufficiently thick coating has been applied to bring the worn metal part back to its normal diameter. The invention was perfected in April 1940. The inventor chose not to file an application for patent at that time. *Instead he proceeded to immediately employ the process in secrecy for profit.* He advertised his new process to the trade, solicited work through a salesman, and from *April 1940 to August 6, 1942,* the filing date of his application, repaired all sorts of metal parts for the trade as a regular business, and charged each customer for the work. The District Court found that although the operations themselves were carried on in secrecy, the inventor's main purpose in his use of the process for more than one year prior to the filing of his application, was *commercial* and that any experimental purpose was subordinate only. These findings were held to be fully supported by the testimony and accepted by the Circuit Court of Appeals (283 C).* (See findings 10, 11, 12, at 951-952 B).

---

* We follow the same form of reference to the transcript of record as that adopted by petitioner, namely, by page number followed by the letter designating the volume, A, B or C.

The statutory year preceding the application date expired on August 6, 1941. Every metal part that the inventor built up with his new process during the year and four months preceding that date and turned over to the owners thereof, i. e., members of the public, contained the process of the patent. It contained the "thing invented." Each metal part had the electrically deposited bonding layer on which the metal spray had been applied. The Circuit Court of Appeals held under these facts, that the invention had been in public use and/or on sale by the inventor for more than one year prior to the filing of the application and that therefore the forfeiture worked by the statute applied.

The District Court had held otherwise relying upon the finding that the process had been performed secretly and was not detectable from the article treated thereby. Its decision was contrary to the law as established by this Court and the Court of Appeals necessarily had to reverse.

The question here sought to be reviewed is not a novel one. It has been decided adversely to petitioner over and over again by this Court and the Circuit Courts of Appeals.

I

This Court has already definitely refused to grant *certiorari* to review the identical question in *Macbeth-Evans Glass Company* v. *General Electric Company* (246 U. S. 659) (No. 821 October Term, 1917).

In the *Macbeth-Evans* case the petition for the writ (pp. 2-3) stated the "question involved" in the following language:

> "The question is, in view of the foregoing provisions of the Patent Statutes, can an inventor obtain Letters

Patent on a *method* of making glassware, which invention (*the method*) he practiced *in secret,* but not in *public,* for more than two years*, but the *product* of which he sold to the public for more than two years before he filed his application?"

II

The decision of the Court of Appeals in the present case is in harmony with the decisions of this Court, the Circuit Courts of Appeals and the District Courts. No novel question of patent law is presented.

In essense *an old question has been decided according to the highest precedents.*

In this Court the leading case is *Pennock and Sellers* v. *Dialogue,* 2 Peters 1. In that case this Court laid down the underlying principle that: "If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; * * * and make, and sell his invention publicly, and thus gather the whole profits of it * * * and he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries" (p. 19). This was perhaps the first pronouncement by this Court of the underlying reason for the provision in all the patent statutes, from the first enacted to the present, that the invention must not have been known, used, or sold for a prescribed period prior to the application date.

What Congress sought to accomplish at all times was to prevent a delay of the disclosure by the inventor with a

---

* The present statute reads "one year."

consequent extension of his monopoly; and therefore each patent statute has provided for a forfeiture of the right to a patent where the inventor uses his invention competitively for the period beyond that given him in the Statute. The Statute now in force and here applicable states the condition to be that the invention shall not have been "in public use or on sale in this country for more than one year prior to his application." (35 U. S. Code Sec. 31 [R. S. 4886]). An inventor who elects to continue to use his invention competitively for more than that period has elected to forfeit his right to a patent.

It is not material that his operations were carried on in secrecy. If in fact, as was the case here, articles containing the invention or made by the invention were publicly used and sold, then upon the rationale of the *Pennock* v. *Dialogue* decision it should make no difference at all that the patent is for a process and that the process is not detectable from the article to which it has been applied and which has been sold to the public. To hold otherwise would be to discriminate between processes which may be detected and those which may not and to unjustly make an inventor who happened to invent a process which is undetectable, a favorite of the law. Why should the fortuitous circumstance of non-detectability give him any better standing before the law than an inventor who invents a process which is detectable?

Pennock v. *Dialogue* involved a process patent. The patent there was, as Mr. Justice Story stated, "for a new and useful improvement in the *art* of making leather tubes or hose for conveying air, water or other fluids." (p. 14) (italics supplied). And on page 3 the report states that the suit had been instituted "for an infringement of a patent right for 'an improvement in the art of making tubes or hose for conveying air, water and other fluids.' The invention claimed by the patentees was in the *mode of making* the hose so that the parts so joined

together would be tight and as capable of resisting the pressure as any other part of the machine" (italics supplied).

There is no foundation whatsoever for petitioner's contention (petitioner's brief, p. 25) that the patent was not for a process but for a "hose structure". *Pennock* v. *Dialogue*, as Judge Learned Hand correctly stated, was clearly a case on all fours with the case at bar in that it was the hose itself which was publicly sold and the patented process was embodied in the hose, similarly to the situation here.

Pennock v. *Dialogue* has been uniformly followed by this Court and its doctrine reaffirmed and expanded in cases as they arose in connection with the later patent statutes. See *Egbert* v. *Lippmann*, 104 U. S. 333; *Hall* v. *Macneale*, 107 U. S. 90.

The doctrine was reiterated emphatically, quite recently in *Woodbridge* v. *United States*, 263 U. S. 50, in the following language:

> "Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim" (p. 56).

That the Second Circuit Court of Appeals in the case at bar followed the law as laid down by this Court is in itself a complete answer to the only ground upon which the present petition is based.

However, the decision here questioned is also in harmony with decisions of other Circuit Courts of Appeal who have likewise clearly understood and carefully followed *Pennock* v. *Dialogue* and the other decisions of

this Court above noted. See *Allinson Mfg. Co.* v. *Ideal Filter Co.*, 21 Fed. (2d) 22 (CCA8) and *Grasselli Chemical Co.* v. *National Aniline Co.*, 26 Fed. (2d) 305 (CCA2).

Allinson v. *Ideal* did not turn only upon abandonment of the right to a patent as petitioner in its brief, page 28, appears to contend. On the contrary, the Circuit Court of Appeals for the Eighth Circuit also specifically passed upon the issue of public use for more than two years—the then statute. There it was the patented apparatus that was operated in secrecy. The product of the use of the apparatus, namely refined gasoline, is what reached the public. The Court said:

> "He used his apparatus in competitive trade and reaped profits from his customers over and above what he would have received had he contained to use the still or other old methods. It was the intended use and only use to which and for which it was later manufactured and sold. These facts, we think, clearly constituted a public use within the purpose and meaning of the statute" (p. 27).

And in the *Grasselli* case the patent was for a process which had been kept secret but the product had been sold upon the market for more than two years. The Second Circuit Court of Appeals by Judge Learned Hand said:

> "The proof is ample that it was used for vulcanization in large quantities before December 31, 1913, in the factory of the Diamond Rubber Company and that tires were made of the product and sold. This was the only kind of use possible and it was public. In Egbert v. Lippmann, 104 U. S. 333, 26 L. Ed. 755, and Hall v. McNeale, 107 U. S. 90, 2 S. Ct. 73, 27 L. Ed. 367, it was held that a use is public though the invention cannot be learned unless the embodiment of it is destroyed. If the accelerator could have been discovered by dissolving the product into its

constitutents, these cases would directly apply. However, this was not the case before 1914 and there was no way of learning from the product either its composition *or the process by which it had been made.* Such was the case also in Macbeth Evans Glass Co. v. General Electric Co. (D. C. Ohio), 231 F. 183, and it seems to us that the distinction cannot serve to prevent anticipation. It is quite true that the art is not enriched by such a use, but then it is not enriched even if the invention can be learned by destroying the embodiment. The fact that a curious person might disentangle it does not mean that any one will do so, and the discovery remains inaccessible for practical purposes. It might have been proper theoretically to exclude such uses, but we think that the statute has cut the knot. *Once the invention has been embodied in goods which are put in public use it becomes impossible for a later inventor to secure a patent''* (pp. 308-9). (Italics supplied.)

In *Macbeth-Evans etc. Co.* v. *General Electric Co.,* 231 Fed. 183, a process for the manufacture of illuminating glass had been operated in secrecy and the glass produced by the process sold to the public for more than two years prior to the filing of the patent application. The process was in noways disclosed by the glass. The District Court, with special reference to Mr. Justice Story's decision in *Pennock* v. *Dialogue,* and relying also on *Egbert* v. *Lippman* and *Hall* v. *Macneale,* held that that was a public use of the invention such as to work the forfeiture of the statute and said:

> "No case has been cited to the Court where a patent has been held valid after a long commercial but secret use of it, upon the ground that such a use was not a public one within the meaning of the patent statutes" (p. 188).

True, the Sixth Circuit Court of Appeals in 246 Fed. 695, affirmed upon the ground of abandonment and therefore found it unnecessary to pass upon this holding of the lower court that there was a public use. That does not vitiate this holding. Nor could the Sixth Circuit Court of Appeals have done so because that would have been in flagrant disregard of the decisions of this Court already above noted. This is evidenced by the fact that the Court denied *certiorari* when the very question here sought to be reviewed was presented in the *Macbeth-Evans* case (*ante*, p. 3) and by the repeated approval of that case by this Court. See *Woodbridge* v. *U. S.*, 263 U. S. 50, 59; *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, 15.

Petitioner has misconstrued the meaning of the words "public use" in the Statute. The interpretation given by this Court to these words avoids the legal anamoly which would result from exempting processes used in secrecy for profit. The word "public" does not mean exposed to the public. Thus in *Elizabeth* v. *Pavement Co.*, 97 U. S. 126, the pavement was, of course, exposed to the public. But the use was experimental and not for a profit and that saved the patent there from the very condemnation of this Court in the following language:

> "Any attempt to use it for profit, and not by way of experiment, for a longer period than two years before the application would deprive the inventor of his right to a patent" (p. 137).

On the other hand, in *Egbert* v. *Lippmann*, 104 U. S. 333, where the statutory "public use" was found, the patented steel corset stay was placed in a single corset which was worn by a member of the public and certainly was not exposed to public view. Likewise, in *Hall* v. *Macneale*, 107 U. S. 90, the patented bolts used in a safe construction were within a wall of the safe "hidden from view, after the safes were completed" (p. 97). Thus public use

obviously does not connote exposure to the public. Secrecy may be considered only as an evidentiary factor in connection with experimental use. It cannot save an invention against a commercial competitive use.

Kendall v. *Winsor*, 21 Howard 322, is not in conflict with the decision of the Circuit Court of Appeals here. *Kendall* v. *Winsor* merely held that the instructions (pp. 326-327) given by the Trial Judge to the jury were correct and "in strict conformity" (p. 331) with *Pennock* v. *Dialogue*.

Petitioner's effort to distinguish the authorities relied on by insisting on intent to abandon was succinctly answered by this Court in *Woodbridge* v. *United States*, *supra*, in the following language:

> "It is urged that such authorities have no application because intent to abandon cannot be inferred from delay in this case. That is true; but our conclusion rests not on neglect and intention to give up the patent, but on a deliberate and unlawful purpose to postpone the term of the patent the inventor always intended to secure" (263 U. S. at p. 59).

It is submitted, therefore that the petition for the writ of *certiorari* should be denied.

Respectfully submitted,

MORRIS KIRSCHSTEIN,
CLIFFORD H. BELL,
of Counsel for Respondents.

MAY 2 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM, 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,
Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

PETITIONER'S REPLY BRIEF

WILLIAM H. DAVIS
LOUIS BURGESS

TABLE OF CASES CITED

PAGES

Allinson Mfg. Co. v. Ideal Filter Co., 21 F. (2d) 22 (CCA 8) 3

American Whip Co. v. Hampden Whip Co., 4 Fed. 536 (CC D Mass.) 6

Bryce Bros. Co. v. Seneca Glass Co., 140 Fed. 161 (CC ND West Va.) 6

Electric Storage Battery v. Shimadzu, 307 U. S. 5 5

Grasselli Chemical v. Natl. Aniline, 26 F. (2d) 305 (CCA 2) 3

Jenner v. Bowen, 139 Fed. 556 (CCA 6) 5

Kendall v. Winsor, 21 How. 322 ..... 2, 6

Macbeth-Evans Glass Co. v. General Electric, 246 Fed. 695 (CCA 6) 1, 2, 5

Manning v. Cape Ann Isinglass, 108 U. S. 462 5

Paraffine Companies, Inc. v. McEverlast, Inc., 84 F. (2d) 335 (CCA 9) 5

Penn etc. Co. v. Conroy, 159 Fed. 943 (CCA 3) 6

Pennock v. Dialogue, 2 Peters 1 2

Robinson on Patents, Sec. 320 5

Shaw v. Cooper, 17 Peters 292 5

Smith v. Sprague etc. Co., 123 U. S. 249 5

Stresau v. Ipsen, 77 F. (2d) 937 (CCPA) 6

Woodbridge v. U. S., 263 U. S. 50 3

Supreme Court of the United States

OCTOBER TERM, 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITIONER'S REPLY BRIEF

1. Respondent asserts (pp. 3 and 8-9) that in *Macbeth-Evans Glass Co.* v. *General Electric Co.*, 246 U. S. 695, this Court on a petition for certiorari "has already definitely refused to grant certiorari to review the identical question" presented here. But in the *Macbeth-Evans* case the Sixth Circuit Court of Appeals had expressly put aside the question of prior public use and rested its decision wholly on abandonment (see our brief, pp. 21-22). In the instant case, the Second Circuit Court of Appeals, accepting the findings and conclusions of the trial court, expressly put aside the idea of abandonment and held, for the first time in any Court, that secret use of the patented thing accompanied by sale of the unpatented product for more than one year prior to application filed is an absolute bar.

The question propounded to this court in the *Macbeth-Evans* case and now quoted by respondent (pp. 3 and 4) clearly had no actuality in view of the decision of the Court of Appeals in that case.

2. Respondent opposes the grant of the writ on the ground that the decision of the Court of Appeals is in harmony with certain decisions of this and lower federal courts (p. 4). Except as to *Kendall* v. *Winsor,* 21 How. 322, there is, however, no denial that the decision of the Court of Appeals is in conflict with the decisions of this court and of the lower federal courts listed on page 8 of our petition.

As to *Kendall* v. *Winsor,* 21 How. 322, respondents says that it "is not in conflict with the decision of the Circuit Court of Appeals here" (p. 10); but it does not deny that the Second Circuit Court of Appeals was mistaken when it thought that the verdict in the *Kendall* case was for the defendant and voided the patent, whereas, in fact, the verdict was for the plaintiff and upheld the patent. Laboring under this mistake, Judge Hand in his opinion, after pointing out that in the *Kendall* case the facts presented the same situation as here, dismissed the case with the remark that "the case adds nothing" but dicta (285C). But for this mistake Judge Hand would, of course, have recognized that in the *Kendall* case this Court approved a verdict sustaining the patent notwithstanding that "the facts presented the same situation as here"—a clear conflict of decision.

3. Respondent says that the question presented here is an old question "decided according to the highest precedents" (p. 4). It finds support for that assertion in *Pennock* v. *Dialogue,* 2 Peters 1, only by making the same mistake that the Second Circuit Court of Appeals made in supposing that the patent was "for a process of making hose" when, in fact, the patent was for a hose structure

so that the patented thing was the very thing publicly sold and used (our brief, pp. 25-6). Similarly, respondent repeats the mistake of the Second Circuit Court of Appeals in supposing that in *Allinson Mfg. Co.* v. *Ideal Filter Co.*, 21 F. (2d) 22 the refined gasoline was sold to the public. That is not what happened (our brief, pp. 27-28).

Respondent refers to *Grasselli Chemical Co.* v. *National Aniline Co.*, 26 F. (2d) 305 (C. C. A. 2), as a decision in harmony with the decision of the same court in the instant case. However that may be, there is no doubt that the decision of the District Court, reversed by the Circuit Court of Appeals in the instant case "was altogether correct" (283C) on the basis of the law as it stood in the Second Circuit until it was reversed by the decision in the instant case.

4. Respondent also refers to *Woodbridge* v. *U. S.*, 263 U. S. 50 and quotes certain general statements from the opinion without relating them to the facts of that case. The decision had nothing to do with the "public use" statute affecting patents generally. The Patent Office had refused to issue a patent on the ground of abandonment. The action was brought under a special statute permitting recovery against the government despite the fact no patent had issued provided that the Court of Claims "shall first be satisfied that the said Woodbridge did not forfeit, or abandon, his right to a patent, by publication, delay, laches, or otherwise; and that the said patent was wrongfully refused to be issued by the Patent Office". This court affirmed the decision of the Court of Claims that the invention had been forfeited. The case is clearly not applicable here.

5. Respondent flatly contends that we have "misconstrued the meaning of the words 'public use' in the statute" (p. 9) and that the decision of the Circuit Court of Appeals was expressly that under the circumstances of this case "the invention had been in public use and/or

on sale by the inventor for more than one year prior to the filing of the application" (p. 3). Respondent puts its argument thus: (a) that the parts repaired by the inventor in this case "contained the process of the patent. It contained the 'thing invented'" (p. 3); and (b) that "secrecy may be considered only as an evidentiary factor in connection with experimental use. It cannot save an invention against a commercial competitive use".

(a) It is quite clear that the decision of the Circuit Court of Appeals was not based on any such exercise in semantics as that indicated by respondent's first point. The Court fully accepted the finding that the use of the patented process "was not in public but secret" (283 C) and that the patented process could not be detected from the unpatented product of that process (Finding 13, 952 B; 62 F. Supp. 47). Its decision was that competitive exploitation by the inventor for more than one year works an automatic forfeiture of the right to a patent regardless of how secret the use may have been.

(b) Respondent's second point is refuted by the distinction which the Court makes between secret use by an inventor and by a stranger. In the case of a stranger, the Court admits his secret use accompanied by sale of the product is not a bar (287 C).

Respondent complains however that unless use for profit is made the criterion under the statute there would be discrimination between processes which may be detected from the product and those which cannot (p. 5). But discrimination of that sort is inevitable under a statute which sets up a simple and arbitrary formula without attempt at distinction among different fact situations.

The intent of the public use provision of the law was to prevent an inventor from acquiring a monopoly of an

invention "of which they [the public] were fairly in possession." *Shaw* v. *Cooper*, 17 Peters 292, 320. Until the public acquires possession by disclosure the statute does not come into operation.*

The fact of the matter is that Congress after repeated amendments of the patent statutes and with full knowledge of the various possible fact situations has seen fit to cover the matter of secret use under the abandonment provision of the statute which unlike the public use provision is not subject to any fixed and arbitrary time limit but is left at large to be determined on the facts of the particular case. See *Macbeth-Evans* v. *G. E. Co.* (C. C. A. 6), 246 Fed. 695, 702 (our brief pp. 22-23).

We submit that there is a clear conflict with the cases listed on page 8 of our petition not only as a matter of interpretation of the statute but as a matter of decision on facts essentially the same.

The interpretation which the respondent seeks to place on the statute in support of the decision is in conflict with the following decisions since that rule, if it existed, would have rendered unnecessary resort to the ground of decision in each of those cases: *Manning* v. *Cape Ann etc. Co.*, 108 U. S. 462; *Smith etc. Co.* v. *Sprague*, 123 U. S. 249; *Electric etc. Co.* v. *Shimadzu*, 307 U. S. 5; *Jenner* v. *Bowen* (C. C. A. 6), 139 Fed. 556; *Paraffine Companies, Inc.* v. *McEverlast, Inc.* (C. C. A. 9), 84 F. (2d) 335 and *Macbeth-Evans* v. *G. E. Co.* (C. C. A. 6), 246 Fed. 695.

---

* The law is accurately stated in Robinson on patents Sect. 320.

> "A use in public is not necessarily a use by the public. It is distinguished, not from an individual, but from a secret use. It is a use which places the invention in such a relation to the public that if they choose to be acquainted with it, they can do so."

This early statement of the law is in accord with the more recent statement of this court in *Electric Storage etc. Co.* v. *Shimadzu*, 307 U. S. 5, 20 (our brief p. 18).

In the following cases there was a clear conflict of decision since in each case the patent was held valid under substantially the same circumstances as in the instant case: *Kendall* v. *Winsor*, 21 How. 322; *Penn* v. *Conroy* (C. C. A. 3), 159 Fed. 943; *Stresau* v. *Ipsen* (C. C. P. A.), 77 F. (2d) 937; *Amer. Whip Co.* v. *Hampden Whip Co.* (D. C. D. Mass.), 4 Fed. 536 and *Bryce Bros. Co.* v. *Seneca Glass Co.* (C. C. N. D. West Va.), 140 Fed. 161.

Respectfully submitted,

WILLIAM H. DAVIS
LOUIS BURGESS

21

MAY 29 1946

CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI

WILLIAM H. DAVIS.
LOUIS BURGESS.

TOPIC INDEX

PAGE

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI 1

PRAYER 2

BRIEF IN SUPPORT OF PETITION FOR REHEARING 4

I. The Decision of the Second Circuit Court of Appeals Construes a Federal Statute, i. e., R. S. 4886 4

II. There is a Clear and Direct Conflict Between the Construction of R. S. 4886 by the Circuit Court of Appeals in this Case and the Interpretation placed Upon that Statute by this Court 7

(a) The "use" or "public use" in the various patent acts which will defeat a patent is a use in or accessible to the public 7

(b) A secret use by the inventor is not a public use under R. S. 4886 10

(c) Mere operation for profit does not make a use that is otherwise secret and private into a public use and R. S. 4886 admits of no distinction in this regard between the inventor and a stranger to the invention 12

III. The Conflict Between this Decision and the Decision of the Court of Customs and Patent Appeals in Stresau v. Ipsen which is Binding on the Patent Office Interferes with the Uniform Administration of the Patent Laws 14

IV. Practical Considerations make it Important and in the Public Interest that this Conflict be Promptly Resolved 17

PAGE

(a) The decision affects the validity of many patents and unless finally determined by this Court will subject numerous inventors and the public to the uncertainty and expense of litigation 17

(b) The decision of the Circuit Court of Appeals places a construction upon R. S. 4886 in derogation of the constitutional mandate to promote the progress of science and useful arts 17

V. The Decision of the Circuit Court of Appeals in this Case is Controlling on the Rights of the Inventor and of the Petitioner and the facts as hereinafter set forth Preclude obtaining a Conflicting Decision in another Circuit 20

Conclusion 21

Affidavit of R. A. Axline 22

A—Preliminary Injunction Issued by Judge Bright ... 26

Appendix 31

Statutes 31

Excerpts from Congressional Records 35

House Bills and Hearings 37

Statutes Cited	Page in Brief	Page in Appendix
Act of Feb. 21, 1793 (1 Stat. 318), Section 1	7	31
Act of July 4, 1836 (5 Stat. 117), Section 6	7, 8	31
Act of Mar. 3, 1839 (5 Stat. 353)	8	32
Act of July 8, 1870 (16 Stat. 198).....	8, 9, 10, 13	32

	Page in Brief	Page in Appendix
Act of 1874	9	33
Act of Mar. 3, 1897 (29 Stat. 692)	9	33
Act of Aug. 5, 1939	10	34
R.S. 4886	5	34
Congressional Globe		
Apr. 14, 1870, p. 2683	8	35
Apr. 21, 1870, pp. 2875-2876	8	35
Apr. 21, 1870, p. 2879	19	36
June 24, 1870, p. 4821	9, 13	36
House Bills		
H. R. 1714 41st Congress 2nd Session	8, 9, 13	37
H. R. 11019 (Kelly Bill)	18	38
Hearings before House Committee on Patents 72 Congress, 1st Session Mar. 30 and 31, 1932 Remarks of Mr. Emery	18	39
Statement of Commissioner of Patents Coe before Temporary National Economic Committee Jan. 16, 1939	18	41
Statement by Dr. Baekeland before Committee on Patents on H. R. 23417, April 26, 1912, p. 29	19	40
Robinson on Patents		
1 Robinson 434	11	

Table of Cases Cited

PAGE

Addison v. Holly Hill Co., 322 U. S. 607, 618 14

Aerovox v. Polymet, 67 F. (2) 860 (CCA 2) 12, 13

Allen v. Blunt, 1 Fed. Cas. 450 (CC D Mass.) 8

Allinson v. Ideal Filter Co., 21 F. (2) 22 (CCA 8) ... 6, 12

Andrews v. Hovey, 123 U. S. 267 8

Andrews v. Hovey 124 U. S. 694 ..... 8, 9

Bates v. Coe, 98 U. S. 31, 46 .....10, 11

Bryce v. Seneca, 140 F. 161, 174 (CC ND W. Va.) 12

Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 94 13

Egbert v. Lippmann, 104 U. S. 333, 336 .....10, 13

Elec. Storage Battery v. Shimadzu, 307 U. S. 5, 20...10, 11, 12, 13

Ellithorp v. Robertson, 8 Fed. Cas. 562, 566 (CC D.C.) 12

Gillman v. Stern, 114 F. (2) 28, 31 (CCA 2) 12, 13, 14

Grasselli Chemical v. Natl. Anilin, 26 F. (2) 305, 309 (CCA 2) 12, 13

Hall v. Macneale, 107 U. S. 90, 97 .....10, 11

Henry v. Providence, 11 Fed. Cas. 1182, 1188 (CC D. R.I.) 7

Hunt v. Howe, 12 Fed. Cas. 918 (CC. D.C.) 12

Jenner v. Bowen, 139 F. 556, 560, 561 (CCA 6) 12

Kendall v. Winsor, 21 How. 322, 329 9

Macbeth-Evans Glass v. Genl. Elec., 246 F. 695 .... 6, 15

Manning v. Cape Ann Isinglass, 108 U. S. 462, 465 .....10, 11, 13

McClurg v. Kingsland, 1 How. 202 8

PAGE

Natl. Tube v. Steel & Tubes, 90 F. (2) 52, 54 (CCA 3) 12

Parks v. Booth, 102 U. S. 96, 105 .....10, 11

Peerless Roll Leaf Co. v. H. Griffin & Sons, 29 F. (2) 646, 648 (CCA 2) 4, 6, 12, 14

Penn. Elec. v. Conroy, 159 F. 943 (CCA 3) 12

Pennock v. Dialogue, 27 U. S. (2 Peters) 1 .....5, 7, 9, 17

Perkins v. Nashua, 2 F. 451 (CC D NH) 12

Pierson v. Eagle, 19 Fed. Cas. 672 (CC D RI).... 8

Pierson v. Elgar, 4 Cranch. C.C. 454 (Fed. Cas. No. 11,157) (CC D. Col.) 7

Reed v. Cutter, 1 Story 597 9

Schrader's Sons v. Wein Sales Corp., 9 F. (2) 306, 307, 308 (CCA 2) 12, 13, 14

Shaw v. Cooper, 32 U. S. 292, 315, 318 ..... 7, 9

Smith Corp. v. Petroleum Iron Works, 73 F. (2) 531, 537 (CCA 6) 12, 18

Smith & Griggs v. Sprague, 123 U. S. 249, 254, 260..10, 11

Stresau v. Ipsen, 77 F. (2) 937 .....2, 15, 16

U. S. v. Stewart, 311 U. S. 60, 63 14

W. R. Co. v. Sova, 106 F. (2) 478 (CCA 6) 12

Woodbridge v. U. S., 263 U. S. 50 11

Worley v. Tobacco Co., 104 U. S. 340, 343 10

Zinsser v. Kremer, 39 F. 111 (CC D NJ) 12

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI AND FOR ISSUE OF A WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Metallizing Engineering Co. Inc., hereby respectfully petitions this Court for a rehearing of its petition for writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit filed herein April 10, 1946 and that this Court, upon such rehearing, vacate the order denying certiorari made May 6, 1946 and grant such petition.

We believe that in denying the petition this Court must have overlooked the following points which in the past have always been considered as compelling reasons for assumption of jurisdiction by this Court. These points are:

1. The decision of the Second Circuit Court of Appeals construes a Federal Statute, i. e. R. S. 4886.

2. There is a clear and direct conflict between the construction of this statute by the Circuit Court of Appeals in this case and the interpretation placed upon that statute by this Court.

3. There is also a clear and direct conflict between the decision of the Second Circuit Court of Appeals in the present case and the Court of Customs and Patent Appeals in *Stresau* v. *Ipsen*, 77 F. (2) 937. This conflict is of a particularly serious nature since the latter decision is binding on the Patent Office and will result in the issuance of patents valid under the *Stresau* decision and decisions of this Court but invalid in the Second Circuit under the decision in the present case.

4. There are practical considerations which make it important and in the public interest that this conflict should be promptly resolved.

5. The decision of the Circuit Court of Appeals in this case is controlling on the relative rights of the inventor and petitioner and of respondent who do 98% of the metallizing business, and the facts as hereinafter set forth preclude obtaining a conflicting decision in another circuit.

These points will be developed in the accompanying brief.

Prayer

WHEREFORE petitioner most earnestly moves and prays this Court for rehearing of its said petition for writ of certiorari and that this Court upon such rehearing vacate the order denying certiorari made May 6, 1946 and extend

its supervisory action to this case and, to that end, issue certiorari to the Circuit Court of Appeals for the Second Circuit.

Respectfully submitted,

WILLIAM H. DAVIS,

LOUIS BURGESS.

We hereby certify that this petition is made in good faith and not for purposes of delay.

WILLIAM H. DAVIS,

LOUIS BURGESS.

BRIEF IN SUPPORT OF PETITION FOR REHEARING

I. The decision of the Second Circuit Court of Appeals construes a Federal Statute, i. e., R. S. 4886.

Insofar as the use by the inventor is concerned, the facts are stated in Findings 8-13 (B[1] 949-952; 62 Fed. Supp. 46-47) and are summarized as follows: The inventor was genuinely engaged in a program of testing to ascertain whether his invention could safely be released for general use and while so engaged rebuilt some parts by the application of the patented process as to which his purpose was not predominantly experimental. This work was conducted in secret and the public derived no knowledge of the process from the parts rebuilt. There was no intent to abandon. There is nowhere in the record the slightest intimation of inequitable conduct.

As pointed out in Conclusion 5 (B 978-980; 62 Fed. Supp. 58):

> "* * * While developing his invention it was necessary for him to continue to earn a living in the little two-man machine shop which he had recently acquired."

This indicates clearly that as to these jobs his primary objective was to support his family and himself while continuing the development of his invention.

On these facts and on the authority of *Peerless Roll Leaf Co.* v. *H. Griffin & Sons Co.*, 29 F. (2) 646, 648, in which the Circuit Court of Appeals for the Second Circuit ruled specifically that such a use is not a public use within the meaning of R. S. 4886, the District Court sustained the patent (Conclusions 4 and 5, B 974-980).

The facts were not disturbed by the appellate court and the decision was overruled on the isolated fact that the

[1] Throughout this brief volumes of the record are designated by the letters A, B or C, followed by the page numbers.

inventor had derived a profit from the operation of his process or, as alternatively stated in the decision, had employed it "to gain a competitive advantage" (C 287).

The decision of the Circuit Court of Appeals rests on a doctrine which the court claims to have been established by the decision of this Court in *Pennock* v. *Dialogue*, 2 Peters (27 U. S.) 1:

> "* * * it is a condition upon an inventor's right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly." (C 287).

The decision assumes that this doctrine controls the construction of R. S. 4886:

> "It is true that for the limited period of two years he was allowed to do so, possibly in order to give him time to prepare an application; and even that has been recently cut down by half. * * * Such a *forfeiture* * * * comes from * * * *the fiat of Congress* that it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure." (C 287).[2]

The decision also shows clearly that in arriving at this conclusion the Court held that operation in secret for profit falls within the public use provision of R. S. 4886.[3]

---

[2] Emphasis ours throughout.

[3] "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Thus, in defining the question presented the Court said (C 283):

> "The only question which we find necessary to decide is as to Meduna's *public use* of the patented process more than one year before August 6, 1942."

In support of its decision the Court refers to *Macbeth-Evans* v. *General Electric Co.*, 246 F. 695, stating (C 285):

> "• • • So far, it was not an interpretation of *'prior use' in the statute;* but, beginning on page 702 Judge Warrington seems to have been construing that phrase and to hold that the sales were such use."

Referring to *Allinson* v. *Ideal Filter Co.*, 21 F. (2) 22, the Court said (C 285):

> "• • • We are disposed however to read the latter part—pp. 27 and 28—as holding that the sale of gasoline was a 'prior use' of the machine, nothwithstanding its concealment."

If there were any doubt as to this point, it is completely dispelled by the fact that the Court correlated its ruling (C 287) with the one year provision of R. S. 4886 which relates to public use and further that it specifically overruled (C 287) its decision in *Peerless Roll Leaf* v. *Griffin, ante,* in which it held that such a use is not a public use within R. S. 4886.

II. There is a clear and direct conflict between the construction of R. S. 4886 by the Circuit Court of Appeals in this case and the interpretation placed upon that statute by this Court.

(a) The "use" or "public use" in the various patent acts which will defeat a patent is a use in or accessible to the public.

The Patent Act of February 21, 1793 (1 Stat. 318)[4] prescribed that an invention shall be "not known or used before the application"[5].

This Court, in *Pennock* v. *Dialogue, ante,* and in *Shaw* v. *Cooper,* 32 U. S. 292, 315, 318, characterized the use that would operate under this statute to defeat a patent as a use in public or by the public.

In the Act of July 4, 1836 (5 Stat. 117) which superseded all previous acts relating to patents, the expression "public use" was adopted and applied by Congress to a use by the inventor or discoverer, i.e.:

> Sec. 6—"* * * and not, at the time of his application for a patent, *in public use* or on sale, with his consent or allowance, as the inventor or discoverer; * * *".[6]

This Act permitted no public use of the invention prior to the application for patent and the rule was so harsh[7]

---

[4] Pertinent sections of the Patent Acts herein referred to are reproduced in the Appendix.

[5] App., p. 31.

[6] App., pp. 31-32.

[7] *Henry* v. *Providence,* 11 Fed. Cas., 1182, 1188 (C. C. D. R. I.); *Pierson* v. *Elgar,* 4 Cranch. C. C. 454 (Fed. Cas. No. 11,157, C. C. D. Col.).

that it was supplemented by the Act of March 3, 1839 (5 Stat. 353)[8] which made such a use with the consent of the inventor ineffective to defeat a patent unless more than two years prior to the application therefor. This was subsequently interpreted by this Court to also apply to the inventor's own use and even to a use by strangers to the invention.[9]

While the supplemental Act of 1839 did not contain the words "public use" or "use in public" the courts made it clear that the use contemplated was a use in public.[10]

The co-existing Acts of 1836 and 1839 were superseded by the Act of July 8, 1870 (16 Stat. 198) which recast the patent law in substantially the present form. As stated by Mr. Jenckes, chairman of the House Committee on Patents, in introducing the bill (H.R. 1714) which became this act, the purpose was to enlarge and clarify the provisions of the previous acts.[11] Mr. Myers of the House Patent Committee stated on the same occasion that the law with respect to the meaning of "public use" was intended to remain unchanged.[12]

The Act of 1870 prescribes as a condition to patentability (Section 24):

---

[8] App., p. 32.

[9] *Andrews* v. *Hovey*, 123 U. S. 267; *Andrews* v. *Hovey*, 124 U. S. 694.

[10] *McClurg* v. *Kingsland*, 1 How. 202; *Pierson* v. *Eagle*, 19 Fed. Cas. 672 (C. C. D. R. I.); *Allen* v. *Blunt*, 1 Fed. Cas. 450 (C. C. D. Mass.).

[11] Congressional Globe, April 14, 1870, p. 2683, App., p. 35. Pertinent excerpts of the Congressional records herein referred to are reproduced in the Appendix.

[12] Congressional Globe, April 21, 1870, pp. 2875-2876, App., p. 35.

"* * * not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, * * *."[13]

In 1874, Section 24 of the Act of 1870 became Section 4886 of the Revised Statutes.[14]

Under this statute, the use that will defeat a patent is therefore identical with that of the preceding Acts. The use is however now for the first time defined without reference to the user and any distinction between the patentee and a stranger to the patent was deliberately abolished.[15] The relationship between this and the preceding Acts was comprehensively reviewed by this Court in *Andrews* v. *Hovey,* 124 U. S. 694.

Various decisions are cited on the margin of the original House bill which became the Act of 1870[16] (H. R. 1714)[17] holding the use comprehended by prior statutes to be a *use in or accessible to the public.* The citation of these cases shows that the meaning of the expression "public use" had become fixed and that the integration of this expression into the Act of 1870 carried forward *that* established meaning.

Though the statute was thereafter amended in other respects, the public use provision thereof remained unaltered. By the Act of March 3, 1897[18] its application was

---

[13] App., pp. 32-33.

[14] App., p. 33.

[15] Congressional Globe, June 24, 1870, p. 4821, App., p. 36.

[16] *Kendall* v. *Windsor,* 21 How. 329 (citing and reaffirming *Pennock* v. *Dialogue, supra,* and *Shaw* v. *Cooper, supra*); *Reed* v. *Cutter,* 1 Story 597 (Justice Story citing *Pennock* v. *Dialogue, supra*).

[17] 41st Congress, 2nd Session, App., p. 37.

[18] App., p. 33.

restricted to this country and by the Act of August 5, 1939[19] the statutory period was reduced from two years to one year.[20]

Following the passage of the Act of 1870 this Court has repeatedly reaffirmed the meaning of public use as so incorporated in that statute as a use in public or accessible to the public. Thus in *Manning* v. *Cape Ann Isinglass,* 108 U. S. 462, 465, this Court defined "public use" within the meaning of R.S. 4886 as "a use open to the public." In *Smith & Griggs* v. *Sprague,* 123 U. S. 249, 254 the "public use" of the statute was held to be one "in the view of such part of the public as choose to resort to his (the patentee's)[21] establishment." And in the more recent case of *Electric Storage Battery* v. *Shimadzu,* 307 U. S. 5," the "public use" under the patent act was defined as a "use for profit not purposely hidden." Other decisions of this Court are of the same import: *Bates* v. *Coe,* 98 U. S. 31, 46; *Parks* v. *Booth,* 102 U. S. 96, 105; *Egbert* v. *Lippmann,* 104 U. S. 333, 336; *Worley* v. *Tobacco Co.,* 104 U. S. 340, 343; *Hall* v. *Macneale,* 107 U. S. 90, 97.

(b) A secret use by the inventor is not a public use under R. S. 4886.

This Court in *Bates* v. *Coe* (*ante*) clearly recognized a public use under the statute to be distinct from a secret use and that a secret use does not fall under the public use provisions of R.S. 4886, stating:

> "Inventors may, if they can, keep their inventions secret; and if they do for any length of time, they do not forfeit their right to apply for patent, unless

---

[19] App., p. 34.

[20] For full text of R. S. 4886 as amended in 1939 see App., p. 34.

[21] Parenthesis ours.

another in the meantime has made the invention * * *. Within that rule and subject to that condition, inventors may delay to apply for a patent;" (p. 46)

And again in *Parks* v. *Booth* (*ante*):

"Inventors may, if they can, keep their inventions secret; but if they do not, and suffer the same to go into public use for a period exceeding what is allowed by the patent act, they forfeit their right to a patent. * * * Unless inventors keep their inventions secret they are required to be vigilant in securing patents for their protection; and if they do not, and suffer the same to be in public use or on sale in this country for more than two years before they apply for a patent, they forfeit their right." (p. 105)

To the same effect are *Hall* v. *Macneale*, 107 U. S. 96, 97; *Manning* v. *Cape Ann Isinglass*, 108 U. S. 465; *Smith & Griggs* v. *Sprague*, 123 U. S. 260; *Elec. Storage Battery* v. *Shimadzu*, 307 U. S. 20.

The subsisting force of the above quoted language of *Bates* v. *Coe* and *Parks* v. *Booth* was affirmed by this Court in *Woodbridge* v. *U. S.*, 263 U. S. 50.

The principle is succinctly stated by that great philosopher on patent law, Robinson:

"A use in public is not necessarily a use by the public. It is distinguished not from an individual, but from a secret use. It is *a use which places the invention in such a relation to the public that if they choose to be acquainted with it, they can do so.*" (1 Robinson 434)

The decisions by this Court defining "public use" under the statute as distinct from secret use have been con-

sistently followed by the lower courts: *Jenner* v. *Bowen* (C. C. A. 6), 139 F. 556, 560, 561; *Penn. Elec.* v. *Conroy* (C. C. A. 3), 159 F. 943; *National Tube* v. *Steel & Tubes* (C. C. A. 3), 90 Fed. (2) 52, 54; *Allinson Mfg. Co.* v. *Ideal Filter Co.* (C. C. A. 8), 21 Fed. (2) 22; *Smith Corp.* v. *Petroleum Iron Works* (C. C. A. 6), 73 Fed. (2) 531; *W. R. Company* v. *Sova* (C. C. A. 6), 106 Fed. (2) 478; *Hunt* v. *Howe* (C. C. D. C.), 12 Fed. Cas. 918; *Ellithorp* v. *Robertson* (C. C. D. C.), 8 Fed. Cas. 562, 566; *Perkins* v. *Nashua* (C. C. D. N. H.), 2 F. 451; *Zinsser* v. *Kremer* (C. C. D. N. J.), 39 F. 111; *Bryce* v. *Seneca* (C. C. N. D. W. Va), 140 F. 161, 174.

Even the Circuit Court of Appeals for the Second Circuit has consistently applied this definition until its contrary decision here involved: *Schrader's Sons* v. *Wein Sales Corp.* (C. C. A. 2), 9 F. (2) 306, 307, 308; *Grasselli Chemical Co.* v. *Natl. Anilin* (C. C. A. 2), 26 F. (2) 305, 309; *Peerless Roll Leaf* v. *Griffin* (C. C. A. 2), 29 F. (2) 646; *Aerovox* v. *Polymet* (C. C. A. 2), 67 F. (2) 860; *Gillman* v. *Stern* (C. C. A. 2), 114 F. (2) 28, 31.

(c) Mere operation for profit does not make a use that is otherwise secret and private into a public use and R. S. 4886 admits of no distinction in this regard between the inventor and a stranger to the invention.

This Court in *Electric Storage Battery* v. *Shimadzu*[22] had under consideration a use obviously commercial but did not on that account assume it to be a public use and proceeded to determine the date on which it actually became a public use in accordance with the legal principle hereinbefore discussed. Many of the cases in which this Court considered the question of secret use actually involved operations for profit and this Court at no time

[22] 307 U. S. 5, 11.

indicated that this feature would per se vitiate the secret nature of the use.

The Circuit Court of Appeals concedes in its decision (C 287) *that a use in secret not for profit whether by the inventor or anyone else is not a public use within R.S. 4886.* The Circuit Court of Appeals also concedes that the *secret use* of an invention *for profit by others* than the inventor *is not a public use within R.S. 4886.* That Court alleges a distinction however to exist between the inventor and others, claiming that a secret use for profit by the inventor is a public use under R.S. 4886. This distinction is untenable. The statute defines the use comprehended without reference to the identity of the user as a public use. The statutory definition cannot mean one thing in application to the patentee and another and different thing in application to a stranger to the patent.

The Act of 1870 as originally proposed contained such a distinction[23] but this was deliberately eliminated before passage[24] and this Court as well as the lower courts have since consistently interpreted the statute without any distinction between inventors or others than inventors regarding public use.[25] This Court in the *Shimadzu* case, which involved a use by a stranger to the invention, on the question of public use as distinct from secret use, cited cases involving uses by the patentees themselves.[26]

---

[23] See parts bracketed for deletion in H.R. 1714 App., p. 37.

[24] See remarks of the Chairman of the House Patent Committee, Congressional Globe, June 24, 1870, p. 4821, App. p. 36.

[25] *Manning* v. *Cape Ann Isinglass* (U. S.), *ante; Electric Storage Battery* v. *Shimadzu* (U. S.), *ante; A. Schrader's Sons* v. *Wein Sales Corp.* (C. C. A. 2), *ante; Grasselli Chemical* v. *National* (C. C. A. 2), *ante; Aerovox* v. *Polymet* (C. C. A. 2), *ante; Gillman* v. *Stern* (C. C. A. 2), *ante.*

[26] *Consolidated Fruit Jar. Co.* v. *Wright,* 94 U. S. 92, 94; *Egbert* v. *Lippmann,* 104 U. S. 333, 336.

Surprisingly enough, the Circuit Court of Appeals for the Second Circuit in its decision in *A. Schrader's Son's* v. *Wein Sales Corp., ante,* specifically pointed out that no such distinction exists in the law of patents, and in *Gillman* v. *Stern, ante,* the same Circuit Court repeated this holding, citing the *Schrader's* case and *Peerless Roll Leaf* v. *Griffin* (*ante*). The decision in *Gillman* v. *Stern* involved a secret use by a *stranger to the invention,* whereas the *Schrader's* and *Peerless* cases, therein cited for authority that the use was not a public use, both involved a secret use by *the inventor himself.*

Neither may the words "public use" connote the inverse of their accepted meaning.[27] If words are to have any use and meaning as guides for human conduct, a use that is private and secret is not by any stretch of interpretation a public use.

III. The conflict between this decision and the decision of the Court of Customs & Patent Appeals in *Stresau* v. *Ipsen* which is binding on the patent office interferes with the uniform administration of the patent laws.

Judge Learned Hand writing the decision of the Circuit Court of Appeals in the instant case directs attention to the fact that his decision is in direct conflict with the

---

[27] As stated by Mr. Justice Frankfurter in *Addison* v. *Holly Hill Co.,* 322 U. S. 607, 618: "After all, legislation when not expressed in technical terms is addressed to the common run of men and *is therefore to be understood according to the sense of the thing, as the ordinary man has a right to rely on ordinary words addressed to him.*"

And by Mr. Justice Douglas in *United States* v. *Stewart,* 311 U. S. 60, 63: *"It is likewise true that Congress will be presumed to have used a word in its usual and well-settled sense. Old Colony R. Co.* v. *Commissioner,* 284 U. S. 552; *Deputy* v. *du Pont,* 308 U. S. 488."

case of *Stresau* v. *Ipsen*, 77 F. (2) 937, decided by the Court of Customs & Patent Appeals.

The *Stresau* case involved an interference between rival inventors. Stresau, an employee of the A. O. Smith Co., had first conceived and reduced to practice. His process was used in welding at the plant of the A. O. Smith Co. as early as September, 1926 and was adopted as standard practice early in 1927 from which time it was used regularly and continuously up to the filing of his application in February, 1929. This use was secret in that it was not disclosed to the public and the employees of the Smith Co. were under contract not to divulge any of the secret processes or trade secrets of the company to the public.

The exact question considered by the Court was (p. 943):

> "*Did the conduct of Stresau,* concededly the first inventor in fact, or his assignee, *in secretly using his process as a commercial process, for profit,* during most of the period *from* its reduction to practice in, say, September, *1926, until* the filing of the application in February, *1929,* concealing all knowledge of it and its use from the public, in the manner which has been described, *amount to a forfeiture in law of his right to a patent* * * *?"

The decision of the Circuit Court of Appeals for the Sixth Circuit in *Macbeth-Evans Glass Co.* v. *General Electric, ante,* was carefully reviewed and distinguished on the ground (p. 944):

> "* * * that, from the facts appearing, Macbeth's conduct was of a character which led irresistibly to the conclusion that he had elected to pursue the secret use of his process and had 'repudiated' the right to

> secure protection of the patent laws. * * * Macbeth's intention was overwhelmingly demonstrated by his actions."

The Court concluded that there was no proof that Stresau or his assignee had elected to abandon the legal right to patent and reversed the action of the Patent Office denying him the right to a patent. In so deciding, the Court said (p. 495):

> "We fully appreciate the fact that the ultimate and fundamental purpose of the constitutional provision for the grant of patent, and of all the laws relating thereto, is the public benefit. Paragraph 8, § 8, article 1 of the Constitution is the only one of the grants of power to Congress which may be said to state within itself the reason for the grant, viz., 'To promote the Progress of Science and useful Arts'.
>
> "The *Congress,* however, *never has deemed it proper to fix by statute a time within which, after reduction to practice, an application must be filed,* * * *."

This decision in the *Stresau* case is binding upon the Patent Office and the latter must issue patents on the basis of that decision.[28]

There is thus presented by the decision in this case the extraordinary and intolerable situation that patents, presumptively valid in law, will be issued by the Patent Office on the basis of the *Stresau* case but will be invalidated in the Second Circuit because of the contrary decision by the Court of Appeals for that circuit.

---

[28] Prior to issue patents may be subject to public use charges or proceedings before the Patent Office or the Court of Customs & Patent Appeals to investigate and determine any charge of public use as a bar to the patent.

IV. Practical considerations make it important and in the public interest that this conflict be promptly resolved.

(a) The decision affects the validity of many patents and unless finally determined by this Court will subject numerous inventors and the public to the uncertainty and expense of litigation.

There are in force today over 600,000 patents. These were applied for and obtained under that construction of the public use provision of the patent statute which is contained in the clear language of the statute and in the decisions of this Court. In view of the great number of subsisting patents and the frequency with which questions of "public use" come before the courts the number of patents which were obtained under the formerly accepted interpretation of the "public use" provision of R.S. 4886 and which are placed in jeopardy by the instant decision is substantial. If these patents are invalid this should in justice to conflicting interests be promptly and finally determined and if they are not invalid the owners of these patents should be spared the delay, expense and uncertainty of further litigation to determine that point.

(b) The Decision of the Circuit Court of Appeals places a construction upon R. S. 4886 in derogation of the constitutional mandate to promote the progress of science and useful arts.

In undertaking to spell out of the *Pennock* case the rule that (C 288).

> "it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure"

the Circuit Court of Appeals doubtless assumed that this was a salutary principle which would speed up the time

within which inventions become available to the public thereby accelerating the advance of the arts.

This overlooks the fact that the inventor is already under a powerful compulsion to patent his invention if that is at all possible. Thus, as stated by the Circuit Court of Appeals, 6th Circuit in *A. O. Smith Corp.* v. *Petroleum Iron Works*, 73 F. (2) 531, 537:

> "There is, moreover, in the case of patentable processes, every incentive to dispatch in seeking protection of the patent law. Prior to patenting the inventor not only risks the loss of his secret through inadvertence or breach of confidence, but likewise through independent discovery. During his period of monopoly he incurs no such hazard. We cannot lightly assume delay inimical to self-interest."

This compulsion operates exclusively in the direction of enforcing diligence whereas the arbitrary requirement that inventors must file within a specified time following the completion of their invention will in many cases cause inventors to reject the alternative of patenting the same and rely upon continued secret practice, thereby impoverishing the arts and sciences.[29]

This may occur for example because one embodiment of his invention is complete and capable of practical application but the principle involved is not sufficiently understood to permit application for patent. It may occur be-

---

[29] Hearings before the House Committee on Patents, 72nd Congress, 1st Session, March 30 and 31, 1932; remarks of Mr. Emery representing the Boston Patent Law Association in connection with the Kelly bill to limit inventors to two years before filing applications for patent and remarks of Commissioner Robertson on the same bill, App. pp. 38 to 40; Statement of Commissioner of Patents Coe before the Temporary National Economic Committee, January 16, 1939 (XXI J. P. O. S., pp. 112-113) App., pp. 41 to 42.

cause one embodiment of the invention has been completed to the point of beneficial application but there are other important aspects of the invention which must still be experimentally tested before application for patent can be intelligently prepared. It may occur because the inventor has been unable to obtain financial backing and would himself be unable to maintain the patent against potential infringers. It may occur because the inventor is without funds with which to apply for patent. It may occur as in the present case because even though some embodiment of his invention may be practicable under his personal control, he is still engaged in experiment to determine whether it may safely be released and is confronted with the stark necessity of supporting himself and his family.

In all these situations the effect of the instant decision of the Circuit Court of Appeals will be to force the invention into secret use and deprive society of the benefits flowing from its more general application.[30] Even though it does not enrich the arts or permit the invention to be generally applied, the secret practice of his invention is in many cases entirely feasible to the substantial benefit of the inventor and would unquestionably be resorted to in many cases if the rule which the Circuit Court of Appeals has advanced in this case is followed in the interpretation of the patent statute.[31]

It is thus evident that the construction placed upon R.S. 4886 by the decision of the Circuit Court of Appeals is in derogation of the constitutional mandate to Congress to "promote the progress of science and useful arts."

---

[30] Remarks of Mr. Jenckes, Chairman of the House Patents Committee in introducing the 1870 bill, Congressional Globe April 21, 1870, p. 2879; App., p. 36.

[31] Statement by Dr. Baekeland before the Committee on Patents on H. R. 23417, April 26, 1912, p. 29, App., p. 40.

V. The decision of the Circuit Court of Appeals in this case is controlling on the rights of the inventor and of the petitioner and the facts as hereinafter set forth preclude obtaining a conflicting decision in another circuit.

The real party defendant in this case is the Metallizing Company of America, a co-partnership. It openly controlled and conducted the defense and is therefore in privity with the nominal defendants (B 942; C 86-87).

Shortly after the process of the patent in suit was communicated to the trade by petitioner, the said Metallizing Company of America began promoting the use of the process of the patent in suit by a nationwide campaign inciting the trade to disregard the patent and practice the process (Axline Affidavit, p. 24, Sec. 5).

Since the District Court did not in this case have personal jurisdiction over the persons composing the said Metallizing Company of America, a suit was started by petitioner in the District Court for the Southern District of New York against said Metallizing Company of America and the persons composing the same to restrain their continued infringement of the patent and a preliminary injunction restraining such infringement was issued by Judge Bright in said suit on August 22, 1945 (*post*, p. 26). This preliminary injunction was dissolved by stipulation immediately following the decision of the Court of Appeals in this case.

Metallizing is practiced by thousands of small machine shops distributed over the entire country (Axline affidavit, p. 22, Sec. 1). Said Metallizing Company of America (together with its affiliate, Metallizing Company of America, Inc., a California corporation) and your petitioner herein, are the principal manufacturers and suppliers in the metallizing field. They occupy the field substantially

exclusively. They collectively supply 98% or more of the metallizing equipment in use in this country and are the only concerns in this field with national distribution. They are the only concerns promoting the use of the process of the patent in suit.

The present holding of invalidity of the patent in suit by the Circuit Court of Appeals automatically determines the outcome of the said suit against Metallizing Company of America establishing the right of said Metallizing Company of America to continue its nation wide program of inciting and promoting infringement. A final adjudication in this case will therefore be conclusive of the entire controversy, making it impossible for petitioner to obtain a conflicting decision in any other circuit.

Conclusion

The decision of the Circuit Court of Appeals in this case construes a federal statute, *i. e.*, R.S. 4886. There is a direct conflict between that construction and the construction placed upon that statute by this Court and by the Court of Customs and Patent Appeals. It is important to the public and in the interest of uniform administration of the patent laws that this conflict should be resolved promptly.

The decision of the Circuit Court of Appeals in this case precludes obtaining a conflicting decision in another circuit.

WHEREFORE your petitioner prays this Court to vacate the order of May 6, 1946 denying the petition for certiorari and issue certiorari to the Second Circuit Court of Appeals in this case.

Respectfully submitted,

WILLIAM H. DAVIS.
LOUIS BURGESS.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO INC., *et al.*,

Respondents.

STATE OF NEW YORK }
COUNTY OF QUEENS } ss.:

REA A. AXILINE, being duly sworn, deposes and says:

1. That he is and at all times subsequent to its incorporation has been President of the above named petitioner, Metallizing Engineering Co. Inc. That said petitioner is engaged in the manufacture and sale of equipment for metallizing and in the sale of materials required in metallizing. Metallizing is carried out by thousands of plants and machine shops distributed over the country and is principally occupied in rebuilding machine parts.

2. That in April, 1942 petitioner acquired title to the invention described and claimed in the patent in suit from the inventor John Frank Meduna, who was then conducting a small machine shop in Seattle, Washington. That up to this time it was difficult or impossible for the metallizing industry to rebuild machine parts which were hard (case hardened) or especially tough (certain alloys) which

constituted the majority of the machine parts available for rebuilding. This problem appeared to be solved and eliminated by the process of the patent in suit. Under petitioner's agreement with the inventor the invention was to be made available to the trade through the system of national distribution maintained by petitioner, the inventor taking as his principal compensation therefor a percentage of the gross profits derived from licensing the invention to the trade. The patent in suit issued to petitioner as assignee of said John Frank Meduna on May 25, 1943.

3. That after entering into said contract with the inventor and upon completion of this program of testing to ascertain whether the invention could safely be released for general use, petitioner communicated the existence of the invention to the trade through advertisements in early 1943, making the invention available to the trade for unlimited use with the designated power source at an annual royalty of about $600, which on March 1, 1945 was reduced to about $250.

4. That when the invention of the patent in suit was communicated to the trade by petitioner, it was immediately and favorably accepted and a substantial number of metallizers began the use of the process under license from petitioner. Also metallizers in various areas commenced infringement of the process, for which reason six suits were started by petitioner against infringers in selected areas to restrain such infringement. On investigation it was found that in each case the infringements had been promoted and incited by the Metallizing Company of America, which is in privity with the defendants Kenyon herein and which is also engaged in the sale of equipment and supplies to the metallizing industry. Three such suits were concluded by consent decrees restraining infringement. This case was continued as a test case between your petitioner and said Metallizing Company of America and

two were held in abeyance, pending the outcome of this case.

5. Following the commencement of this suit the said Metallizing Company of America continued to promote and incite infringement of the patent in suit and conducted a nation-wide campaign inciting the trade to disregard the patent and practice the process of the patent in suit. On June 14, 1944 petitioner started suit in the District Court of the United States for the Southern District of New York against said Metallizing Company of America to restrain the unlawful acts of infringement committed by said company and on August 22, 1945 in said suit a preliminary injunction, copy of which is hereto annexed, marked A, was issued restraining such infringement. This injunction was dissolved by stipulation immediately following the decision of the Circuit Court of Appeals in this case.

6. That your petitioner and said Metallizing Company of America (including its affiliate Metallizing Company of America, Inc., a California corporation) are the principal manufacturers and suppliers in the metallizing field. Collectively they occupy the field substantially exclusively. They supply 98% or more of the metallizing equipment in use in this country and are the only concerns in this field with national distribution. They are the only concerns promoting the use of the process of the patent in suit.

7. That since the field of selling metallizing equipment and supplies is substantially exclusively occupied by said Metallizing Company of America and your petitioner, a final decision in this case holding the patent invalid and establishing the right of said Metallizing Company of America to continue its nation-wide program of inciting and promoting infringement would for all practical purposes conclusively establish the invalidity of the patent in suit and dispose of the entire controversy, thereby making it impossible for petitioner to obtain a conflicting decision in other circuits.

8. Immediately following the decision of the Circuit Court of Appeals herein all the royalty payments under the patent in suit were suspended and forgiven and the following notice was sent to all licensees:

> "On January 10, 1946 the Circuit Court of Appeals, Second Circuit, held invalid U. S. Patent No. Re. 22,397 which is one of the patents under which you are licensed.
>
> "The decision was based on a legal technicality involving a new interpretation of the law. It was not based on lack of invention or prior use by others. We believe the decision to be wrong and are taking steps to have it reversed.
>
> "The decision is binding only in the states of New York, Connecticut and Vermont, and it only affects one of the patents under which you are licensed. Nevertheless, pending a clarification of the law involved in the decision, effective January 11, 1946, all payments under your FUSE BOND license are suspended and will be forgiven until the U. S. Patent No. Re. 22,397 has been declared valid by either the Second Circuit Court of Appeals or the United States Supreme Court.
>
> "Since you have made payment in advance under your license, we are refunding the suspended and forgiven portion of your advance payment.
>
> "Keep your FUSE BOND license because it remains in force and permits you to operate under these Patents, although payments are suspended and forgiven as outlined above."
>
> REA A. AXLINE.

Sworn to before me this
28th day of May, 1946.

DOROTHY E. HUBNER
Notary Public, Queens County
Clerk's No. 1121, Reg. No. 96-H-8
Comm. expires March 30, 1948

A

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

Civ. 26-150

METALLIZING ENGINEERING CO., INC.,

Plaintiff,

against

METALLIZING COMPANY OF AMERICA, LARRY E. KUNKLER, VERNON A. COOK, IRVING BALTIMORE,

Defendants.

Preliminary Injunction

This cause came on to be heard on plaintiff's motion for a preliminary injunction and the Court having considered the verified complaint, the affidavits and attached exhibits submitted in support of the motion, and the affidavits and attached exhibits in opposition thereto, the Court makes the following:

Findings of Fact

1. The patent in suit, United States Letters Reissue Patent No. Re. 22,397 was litigated in the United States District Court for the District of Connecticut in the case of *Metallizing Engineering Co. Inc.* v. *Kenyon Bearing & Auto Parts Co. Inc. et al.*, resulting in a decree in favor of plaintiff. 65 U. S. P. Q. 344;

2. The defendants in the present case assumed and conducted the defense of that litigation in behalf of their customer, the Kenyon Bearing & Auto Parts Co. Inc. and the Kenyons individually;

3. An appeal is now pending from the decree in said Connecticut case;

4. The defendants for the purpose of advancing the sale of their Mogul electric bonder, a transformer which may be used for the purpose of preparing a metal surface for metal spraying, as well as for other purposes, have practiced the process described and claimed in plaintiff's U. S. Letters Reissue Patent No. Re. 22,397 in demonstrating to others how said transformer may be used;

5. Defendants have incited others to practice the process described and claimed in plaintiff's U. S. Reissue Patent No. Re. 22,397 by instructing them how to do so, by distributing written instructions to that end, by advising them that the said patent is invalid and should be disregarded and by advising and agreeing with purchasers of their said transformer that defendants would safeguard and indemnify purchasers of said transformer against the consequences of such infringement;

6. The defendants have failed to show misuse of the reissue patent in suit;

On the basis of the foregoing the Court makes the following:

Conclusions of Law

1. The defendants are bound by the adjudication in the said case of *Metallizing Engineering Co. Inc.* v. *Kenyon Bearing & Auto Parts Co. Inc. et al.*, and the patentability of the process of the patent in suit, U. S. Letters

Reissue Patent No. Re. 22,397 is no longer a question between the parties to this suit;

2. The pendency of the appeal from the decision in the said Kenyon case does not militate against the efficacy or binding effect thereof;

3. Defendants have directly infringed the patent in suit and should be enjoined from so doing;

4. The defendants have, contributorily and jointly with others, infringed the reissue patent in suit and should be enjoined from doing so;

Ordered

WHEREFORE it is hereby

ORDERED, ADJUDGED and DECREED that the defendants herein and each of them and those controlled by and in privity with said defendants and each of them, be and they hereby are restrained and enjoined, pending the determination of this action:

(a) from directly or indirectly practicing or causing to be practiced the process involving the improvement in the application of spray metal to metal surfaces, in accordance with or embodying any invention of the United States Letters Reissue Patent No. Re. 22,397; and from infringement upon or violating the said United States Letters Reissue Patent No. Re. 22,397 in any way whatsoever;

(b) from participating or collaborating in, instigating, aiding or abetting, directly or indirectly, the practice by others of the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Re-

issue Patent No. Re. 22,397, or otherwise violating the said Letters Reissue Patent No. Re. 22,397 in any way whatsoever;

(c) from directly or indirectly infringing the said United States Letters Reissue Patent No. Re. 22,-397

(1) by instructing any individual, firm, corporation or association in the operation of the process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(2) by themselves practicing in the course of such instruction the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(3) by disseminating, distributing or issuing to any individual, firm, corporation or association, pamphlets, advertisements, magazines, articles or any other writing inducing or tending to induce such individual, firm, corporation or association to practice the said process involving the improvement in the application of spray metal to metal surfaces in accordance with or embodying any invention of the said United States Letters Reissue Patent No. Re. 22,397;

(4) by advising any individual, firm, corporation or association or inferring to any individual, firm, corporation or association, that the said

United States Letters Reissue Patent No. Re. 22,397 is invalid and should be disregarded and may be infringed;

(5) by advising and inferring to any individual, firm, corporation or association, or promising that if they would infringe said United States Letters Reissue Patent No. Re. 22,397, the defendants would safeguard them against the consequences of infringement and would indemnify them against such consequences;

(6) by contracting with any individual, firm, corporation or association to safeguard them against the consequences of infringement of said Letters Reissue Patent No. Re. 22,397, and/or to indemnify them against the consequences of such infringement;

It is further ORDERED, ADJUDGED and DECREED that said defendants and each of them and those controlled by and in privity with said defendants and each of them, pending the determination of this action, be and the same hereby are required to give notice in writing to any and every purchaser of their Mogul transformer that the same is not to be used in the practice of plaintiff's patented process covered by U. S. Letters Reissue Patent No. Re. 22,397 except with plaintiff's written consent or license;

It is still further ORDERED, ADJUDGED and DECREED that the plaintiff first give security in the sum of Five Thousand ($5000) Dollars for the payment of such costs and damages as may be incurred or suffered by any party hereto who is found to have been wrongfully enjoined or restrained, any bond to be approved by the Court or the Clerk thereof.

JOHN BRIGHT,
Judge, United States District Court.

Dated: August 22nd, 1945.

APPENDIX

STATUTES

Patent Act of 1793.

1 Statutes at Large, 318.

An Act to promote the progress of useful Arts; and to repeal the act heretofore made for that purpose.

§ 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State, to cause Letters Patent to be made out in the name of the United States, bearing teste by the President of the United States, * * *.

Patent Act of 1836.

5 Statutes at Large, 117, 119

§ 6. *And be it further enacted,* That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in pub-

lic use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. * * *

PATENT ACT OF 1839.

5 Statutes at Large, 353, 354

An Act in addition to "An act to promote the progress of the useful arts."

§ 7. *And be it further enacted,* That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefore to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

CONSOLIDATED PATENT ACT OF 1870.

16 Statutes at Large, 198, 201

An Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights.

§ 24. *And be it further enacted,* That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new

and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.

THE REVISED STATUTES.

(As Approved June 22, 1874.)

Relating to Patents.

§ 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon the payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

PATENT ACT OF 1897.

29 Statutes at Large, 692

An Act Revising and amending the statutes relating to patents.

"§ 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any

foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

REDUCING PUBLIC USE PERIOD TO ONE YEAR

(Public—No. 286—76th Congress)
(Chapter 450—1st Session)

(H.R. 6872)

AN ACT

To amend sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69 and 73).

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 32, 69, and 73) be amended by striking out the words "two years" wherever they appear in said sections and substituting therefor the words "one year".

§ 4886 (35 USC 31) Inventions patentable

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country

for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

EXCERPTS FROM CONGRESSIONAL RECORDS

The Congressional Globe

April 14, 1870 page 2683, col. 1

Mr. Jenckes. "These are the amendments to the law of patents. There are not new nor additional provisions except in the case of the payment of the fee during the term of the patent, to keep it alive. In other respects the law stands without any other change than that it is enlarged, defined, made clear in its terms and provisions and in its proposed execution, so that the remedies can be pursued without mistake and with effect."

The Congressional Globe

April 21, 1870 pages 2875, 2876, cols. 3, 1

Mr. Myers. "A word, now, to my friend from Massachusetts, (Mr. Butler,) who objects to that section of the bill which limits the time, or creates a statute of limitations in regard to abandonment of applications. Mr. Speaker, a man may originate an invention and keep it within his own breast, and may apply for a patent when he pleases, and obtain it, unless he allows it to go into public use for two years, or delays till another applies for and obtains a patent. The law is not altered in this respect. We have no control over that which is not made known. When the secret is disclosed it may be as valuable as when the idea was first conceived and perfected, and we do not propose to interfere with the law in this respect; but after a man once applies for a patent and is rejected, or withdraws his application, or fails to pros-

ecute it, there should be a limit of time in which he can keep his claim alive. This is in the interest of true invention and against the policy of litigation * * *."

THE CONGRESSIONAL GLOBE

April 21, 1870 page 2879, col. 1

MR. JENCKES. "Without this protection we should return to the era of 'secrets,' when every valuable discovery was carefully guarded by its possessor, or parted with only upon terms which required the purchaser to be equally silent and uncommunicative. The public obtained no useful knowledge of the art and but a limited advantage from the working of the discovery. The evil consequences of that system were twofold. The knowledge of many valuable inventions and discoveries died with their possessors and are now among the lost arts; on the other hand, empirical processes of fictitious value were imposed upon manufacturers under the guise of 'secrets' in the arts, and the whole subject of invention and the character of inventors became discredited and debased. The injury to the progress of the useful arts by these pretended secrets has been greater a thousandfold than any that has arisen from the abuse of even the most imperfect system of patent laws."

THE CONGRESSIONAL GLOBE

June 24, 1870 page 4821, col. 2

THE PRESIDING OFFICER. "The next amendment was in section sixty-one, line twenty-six, to strike out the words 'with his consent;' so that the clause will read:

> "Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.
>
> "The amendment was agreed to."

H. R. 1714.

t CONGRESS,
2D SESSION.

IN THE HOUSE OF REPRESENTATIVES.

APRIL 7, 1870.

d twice, ordered to be printed, and recommitted to the Committee on Patents. Strike out the parts within [brackets] and insert the parts in *italics*.

JENCKES, from the Committee on Patents, reported the following bill:

A BILL

o revise, consolidate, and amend the statutes relating to patents and copyrights.

What may be patented.

4 July, 1836, ch. 357, §§ 6, 7, v. 5, pp. 119, 120
3 Mar., 1839, ch. 88, § 7, v. 5, p. 354.
29 Aug., 1842, ch. 263 § 3, v. 5, pp. 543, 544.
2 Mar., 1861, ch. 88 § 11, v. 12, p. 248.

SEC. [23.] 24. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, [before his invention or discovery thereof, and not at the time,] *and not* patented, or described in any printed publication in this or any foreign country, [nor] *before his invention or discovery thereof, and not* in public use or on sale [with his consent] for more than two years prior to his application, [or except] *unless* the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.

Pet. C. C., 341, 400.
4 Wash., 12.
1 How., 208.
15 How., 267.
10 How., 496.
1 Gall., 480.
3 Wheat., 516.
2 Story, 411.
15 How., 267.
11 How., 265.
14 How., 175.
2 Wall, jr., 360.
3 Sumn., 518.
Brightley, 99.
4 McLean, 180, 461.
4 Wash., 52.
1 Blatch., 248, 463, 494
1 Wash., 171.
3 Wash., 198.
1 Gall., 439, 479.
2 Gall., 53.

et. C. C., 342. 1 Mass., 476. 7 Wheat., 430. 4 Mass., 7. Bald., 2 McLean, 178. 5 McLean, 88. 2 Blatchf., 200, 237, 243, 278. enn., 352. 1 Curt., 293. 15 How., 122. 6 McLean, 347, 561. mn., 487. 2 Story, 194, 411. 1 Story, 281, 597. 4 How., 2 Wood. & Min., 143. 2 Curt., 555. 21 How., 329.

sed the House of Representatives
April 21, 1870.

est: EDWARD McPHERSON, *Clerk.*
By CLINTON LLOYD, *Chief Clerk.*

H. R. 11019

72D CONGRESS
1ST SESSION

IN THE HOUSE OF REPRESENTATIVES

MARCH 31, 1932

Mr. Kelly of Illinois introduced the following bill; which was referred to the Committee on Patents and ordered to be printed.

A BILL

To limit inventors to priority of two years before filing applications for patent.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4886 of the Revised Statutes (U. S. C., title 35, sec. 31) be, and the same is hereby, amended to read as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceeding had, obtain a patent therefor.

"If in any proceeding involving an application for patent, or in any suit in law or in equity involving an application for patent or a right arising out of the grant of a patent thereon, there shall be submitted satisfactory proof of invention or discovery by such applicant or patentee of the subject matter patented or sought to be patented at a date more than two years before the filing of the earliest application for patent upon which such applicant or patentee may rely for constructive reduction to practice of the invention, such proof shall be held to establish invention or discovery no more than two years prior to the filing of such earliest application: *Provided, however,* That there shall be excepted from the operation of the foregoing provisions all patents heretofore granted, all applications heretofore filed, all applications filed after the passage of this Act wherein the applicant is entitled to rely for constructive reduction to practice upon an application heretofore filed, as well as patents granted on any such applications."

Hearings before the House Committee on Patents, March 30 and 31, 1932 (page 93)

MR. EMERY. "The bill offered by Mr. Kelly to limit inventors to priority of two years before filing applications for patents, the Boston Patent Law Association is strongly opposed to, because it shuts off the applicant from carrying his invention back to a very short time.

THE CHAIRMAN. "How many years would you grant, Mr. Emery?

MR. EMERY. "I would grant him whatever is necessary.

THE CHAIRMAN. "Wait a minute. I am asking you a specific question.

MR. EMERY. "Whatever number of years was necessary to permit him to show the true facts as to his invention. Now, if your honor please, this touches upon something that is going to work to the commissioner's disad-

vantage and to the applicant's disadvantage rather than to his advantage. We have always been taught to believe, and the courts have encouraged, applicants waiting until their inventions were in really definite shape and fairly well worked out before filing their applications for letters patent. If you are going to prevent them from going more than two years back of their filing date to establish inventions, you are going to make it necessary for inventors, rich and poor alike, to rush into the Patent Office in many instances before their inventions are matured or reduced to anything like practical, commercial form; and that means that applications will be immature, incomplete, unsatisfactory; and means that an applicant must file a second or perhaps a third application later on in order to protect his invention, and that would put an additional burden on the Patent Office * * *."

(Page 104)

MR. ROBERTSON. "When you take a poor inventor who has made different inventions, and has great difficulty in getting the wherewithal to file applications on one of those —it takes all of the resources that he has to get one or two of them, and he has four or five inventions—that man may be precluded from having a patent which he would otherwise be entitled to, and he is the one on whom this bill would rest."

Hearing before the Committee on Patents on
H.R. 23417 April 26, 1912 (page 29)

MR. BAEKELAND. "* * * When an inventor asks me whether he shall take out a patent in the United States I tell him, 'Have you got the money to maintain your rights and to defend them in case of infringement? If not, do not lose any time or any money in taking out a patent; keep the matter secret.' I did so myself. My first successful invention here in this country was a new photo-

graphic process, called 'Vellox' paper. At that time I was not rich enough to take out a patent and to defend it at the same time. So I knew that my competitors would have swamped me by infringing the patent, and there would have been very little chance of my defending my rights. So I practiced it secretly, and after I made business a success, then I sold out to a large corporation at my terms. Later on——

THE CHAIRMAN. "That was after you got a patent.

MR. BAEKELAND. "I never got a patent for that. The process is still a secret process.

"As to my other inventions, I patented most of them, because I felt I was in a better position to defend my rights. From my personal standpoint, since I am in a position to defend my rights, I feel that I have the benefit of that condition of affairs which enables me to keep out competitors. I am speaking very frankly on that subject, so as to impress you with the idea that if I am saying anything here I am animated by personal motive."

STATEMENT OF COMMISSIONER OF PATENTS
CONWAY P. COE

Before the Temporary National Economic Committee
January 16, 1939 (page 107)

"Now it takes him a year, we will say, from that time of his first reduction to practice in the development of the commercial form, to where it can be actually put on the market and sold and be of some benefit to the public. The present statutes than give him two full years in which to publicly use the invention before the application is filed, and so we have here four years that have now elapsed before the application is even brought into the Patent Office.

"The next three years are taken up in the prosecution of the application. Three years have been generally re-

garded as a rather liberal period for the prosecution of most patent applications. The prosecution having been concluded and the patent issued at this point, then the patent life runs for seventeen years and expires at the right-hand end of the chart."

(Pages 112, 113)

"* * * When a patent issues to an inventor we purport to give him the right, the exclusive right, for a term of seventeen years to prevent others from making, using or selling the invention covered by it. But we say that with our tongue in our cheek, for we know better than he that by our present method of adjudicating patent rights he will find it exceedingly difficult to prevent the wrongful appropriation of his property and may be compelled to stand helpless while he is despoiled. As you are aware, if the inventor undertakes to invoke the law for his protection he must file suit in a United States District Court. If the decision of that court be objectionable to him or to the other party, the case must be taken to one of the ten Circuit Courts of Appeals. This in itself is a heavy financial burden, but one which, perhaps most inventors could bear with their own means or the help of others. But having taken this appeal, what has he gained? Hardly more than a ruling as to his rights in that particular circuit. He must then, at least theoretically, go from one to another of all the other circuits, and if purchance from these many litigations there come conflicting decisions, he has the privilege—if he still has the wherewithal—to carry his case to the United States Supreme Court.

"My conviction is that the poor inventor, and through him the public, suffers injustice precisely for the reason and to the extent that the monopoly, the exclusive right, purportedly bestowed on him is not now fully safeguarded."

FILED
MAY 31 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM—1945

No. 1092

METALLIZING ENGINEERING CO. INC.,
Petitioner,

—against—

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR REHEARING

MORRIS KIRSCHSTEIN,
Counsel for Respondents.

Supreme Court of the United States

OCTOBER TERM—1945

No. 1092

METALLIZING ENGINEERING CO. INC.,
Petitioner,

—against—

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR REHEARING

No point is presented in this petition for rehearing which was not fully discussed and presented to this Court in the briefs and the Petition for Writ of Certiorari.

No new fact or circumstance has arisen or is presented in the Petition for Rehearing.

The claim of impossibility of obtaining a conflicting decision in another Circuit is fully met in the accompanying answering affidavit. The pending suit in the Sixth Circuit referred to in such affidavit is against a user of the Meduna process who purchased an unpatented transformer from the Metallizing Company of America for practicing the process. The privity between Metallizing Company of America and the Aberdeen Motor Supply Co., its customer, defendant in said suit, will not preclude a new decision on the merits and the Sixth Circuit Court of Appeals will be free to agree or disagree with the decision of the Second Circuit Court of Appeals in regard to the invalidity of the Meduna patent.

Also the claim of conflict between the decision of the Second Circuit Court of Appeals herein with *Stresau* v. *Ipsen*, 77 Fed. (2d) 937 is without foundation. The quotation from that case appearing at page 15 of the Petition for Rehearing should be read in connection with the language on page 945 of the report of that case where Associate Judge Garrett points out that:

> "In the case at bar, while there was a period of about 2½ years between the reduction to practice of the Stresau method and the filing of the Stresau application, *the continuous use of it as standard practice was for less than 2 years of that period,* * * *" (Italics supplied).

CONCLUSION

We cannot assume with petitioner that the Court overlooked the very points that are again being made now, and which were presented fully on the Petition for the Writ of Certiorari.

The present petition should clearly be denied.

Respectfully submitted,

MORRIS KIRSCHSTEIN,
Counsel for Respondents.

Supreme Court of the United States

OCTOBER TERM—1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

—against—

KENYON BEARING & AUTO PARTS CO. INC., *et al.,*

Respondents.

Respondents' Answering Affidavit

STATE OF NEW YORK,
COUNTY OF NEW YORK, *ss.*:

MORRIS KIRSCHSTEIN, being duly sworn, deposes and says:

1. I am of counsel for the respondents herein. I am also the attorney for the Metallizing Company of America referred to in the affidavit of Rea A. Axline verified May 28, 1946 accompanying the Petition for Rehearing.

2. The Metallizing Company of America concededly manufactures metallizing equipment, including an unpatented electrical transformer which is used in the practice of the process of the Meduna reissue patent which was held invalid by the Circuit Court of Appeals for the Second Circuit and infringement whereof was charged in this suit. The

respondents herein purchased such a transformer from said Metallizing Company of America. The Metallizing Company of America concededly does not, except in connection with demonstrating and explaining the use of its unpatented transformer, use the process of the Meduna patent. In the suit brought by the petitioner herein against the Metallizing Company of America for infringement of said Meduna patent in the United States District Court for the Southern District of New York, said Rea A. Axline made an affidavit verified the 12 day of June 1945 in support of the motion for preliminary injunction, in which he stated as follows:

> "In or about May, 1943, the defendant Metallizing Company of America began offering for sale and at all times subsequent thereto has been engaged in the sale of an electrical transformer adapted to generate electrical current of the kind and type required in the practice of the process described and claimed in the said patent and the said reissue patent."

3. Another suit for infringement of the Meduna patent was brought by the petitioner, Metallizing Engineering Company, Inc. against another customer of the Metallizing Company of America, to wit, the Aberdeen Motor Supply Co. Inc. of Cleveland, Ohio, who also purchased an electrical transformer from said Metallizing Company of America

and therewith practiced the process of the Meduna patent. Said suit is now pending and is entitled:

IN THE

DISTRICT COURT OF THE UNITED STATES

FOR THE NORTHERN DISTRICT OF OHIO

EASTERN DIVISION

Civil Action No. 21875

METALLIZING ENGINEERING CO. INC.,

Plaintiff,

—against—

ABERDEEN MOTOR SUPPLY CO. INC., WILLIAM BURRER, EMMA BURRER, CHARLES E. CARR and GLADYS CARR,

Defendants.

The trial of the Cleveland suit has been adjourned from time to time and when it last appeared upon the Trial Calendar of that Court, was stipulated off that Trial Calendar pending the final outcome of this present suit. I have been informed by Ray Stewart Gehr, the attorney of record in such suit, that it may again come up for trial in June, 1946.

4. The depositions taken in the instant case with reference to the public use of the process by the patentee Meduna were, by stipulation of counsel, filed for use in the Cleveland suit above mentioned.

MORRIS KIRSCHSTEIN

Sworn to before me this
29th day of May, 1946.

LILLIAN BISGAIER
Notary Public, New York County
N. Y. Co. Clk's No. 189, Reg. No. 554-B-7
Commission Expires March 30, 1947

RECORD PRESS—NYC—REctor 2-2638

FILED
JUN 7 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,
Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,
Respondents.

REPLY TO RESPONDENTS' OPPOSITION TO PETITION FOR REHEARING

WILLIAM H. DAVIS
LOUIS BURGESS

Supreme Court of the United States

OCTOBER TERM 1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

against

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

REPLY TO RESPONDENTS' OPPOSITION TO PETITION FOR REHEARING

Respondents contend (brief in opposition to petition for the rehearing, p. 1) that the decision below in this case is not conclusive of the entire controversy because another case against the Aberdeen Supply Co. involving the same patent is pending in the District Court for the Northern District of Ohio. In that case, as in this, the defendant purchased equipment from the Metallizing Company of America for use in practicing the process of the patent in suit on representation of the Metallizing Co. that they were free to use the process. The decision in the present case is binding between petitioner and the Metallizing Company and will estop petitioner in its other action against Metallizing in which petitioner is seeking to enjoin Metallizing from its practice of inducing use of the process.

Under the decision below, the Metallizing Company is therefore assured of its freedom to sell equipment for use in the process of the patent in suit and to continue its prac-

tice of inducing purchasers of its equipment to practice petitioner's process, which indeed is the reason they buy the equipment.

If petitioner were free under the judgment below to sue customers of the Metallizing Company at will, the freedom of Metallizing to continue its practices in the sale of equipment for use in the process would be largely nullified. The case of *Kessler* v. *Eldred,* 206 U. S. 285, extended to a manufacturer relief against such indirect nullification of a judgment in his favor. The statement in the petition for rehearing that the present case would dispose of the entire controversy was based on that decision. Respondents deny the conclusive effect of the judgment but fail to explain why the protection afforded manufacturers by the *Kessler* v. *Eldred* case should not apply here.

But even if respondents were right, and if petitioner could proceed with suits against customers of the Metallizing Company, that would be one more reason why this Court should take the case now. The only course left open to petitioner would be to sue the users of the process who buy from Metallizing the equipment they use in the process. Those users are small scale operators. As usual, enforcement of a patent against individual users at the consumer level is likely to lead to a multiplicity of suits, as noted in *Kessler v. Eldred, ante.* Such a course on the part of a patent owner is now generally considered to be reprehensible. Its evil would be very real here since the small users are not in a position to afford the expense of an infringement suit and in most cases would be forced to take consent decrees. Yet on respondents' proposition now advanced, that would be the only course open to petitioner by which to seek a contrary decision in another circuit. It is improbable that any such small user would carry the contest to a court of appeals, so the probability of attaining a conflict on this patent is remote indeed, and the available route to that end is an unattractive one contrary to the public interest.

We submit therefore both that respondents fail to meet this point of the petition and that even if they are correct as to petitioner's freedom to sue elsewhere, the circumstances that would attend the exercise of that asserted (but dubious) freedom are such that this Court should not let them occur but should determine the matter in the present case.

Respectfully submitted,

WILLIAM H. DAVIS,
LOUIS BURGESS.

FILED
JUN 7 1946
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM—1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

—against—

KENYON BEARING & AUTO PARTS CO. INC., *et al.*,

Respondents.

RESPONDENTS' REJOINDER TO PETITIONER'S REPLY ON PETITION FOR REHEARING

MORRIS KIRSCHSTEIN,
Counsel for Respondents.

RECORD PRESS—NYC—REctor 2-2638

Supreme Court of the United States

OCTOBER TERM—1945

No. 1092

METALLIZING ENGINEERING CO. INC.,

Petitioner,

—against—

KENYON BEARING & AUTO PARTS CO. INC., *et al.,*

Respondents.

RESPONDENTS' REJOINDER TO PETITIONER'S REPLY ON PETITION FOR REHEARING

Petitioner's reply now shifts the whole weight of the petition to the matter of the claimed privity between Metallizing Company of America and its customers.

Respondents' replied to this point without reference to *Kessler* v. *Eldred* because that decision is clearly inapplicable here, as will be presently pointed out. However, it may be well at the outset to remind this Court that essentially the decision herein by the Circuit Court of Appeals for the Second Circuit has reiterated the law of public use as established by this Court, namely, that use of the invention competitively, that is for profit, for more than the statutory period bars the patent. (See cases cited in Respondents' brief in opposition to the petition for the writ of certiorari, Point II, p. 4.)

Coming now to *Kessler* v. *Eldred*, it is only too clear that that decision does not apply. In *Kessler* v. *Eldred* the patent was for an article—a cigar lighter—and not for a process in which only unpatented apparatus is used. Eldred, the owner of the patent, brought a suit against Kessler alleging that Kessler manufactured cigar lighters in infringement of Eldred's patent. That suit was finally decided in favor of Kessler. Thereafter, Eldred filed another suit for infringement of the same patent against Breitwieser, a customer of Kessler, by reason of Breitwieser's use of the very same cigar lighter which had been passed on in the previous case and had been held free from infringement. Kessler assumed the defense of that suit against his customer and subsequently filed a bill against Eldred to enjoin Eldred from prosecuting any suit against anyone for alleged infringement of the patent by purchase, use or sale of an electric cigar lighter manufactured by Kessler and identical with the lighter which had been adjudicated to be free from infringement in the suit previously brought by Kessler against Eldred.

This Court had certified to it four questions set forth at 206 U. S. 287. It held that the decree in Kessler's favor entitled Kessler to continue the business of manufacturing and selling his cigar lighters without molestation by Eldred through the patent he owned. This was the Court's answer to the first question. This Court also answered the second question in the affirmative, namely that that decree had the effect of making a suit by Eldred against another customer of Kessler for alleged infringement of the patent by use or sale of Kessler's lighters a wrongful interference with Kessler's business.

In *Kessler* v. *Eldred* this Court did not pass upon the issue whether the judgment between Kessler and Eldred was a bar to the suit Eldred brought against Breitwieser. This Court said:

"Whether the judgment between Kessler and Eldred is a bar to the suit of Eldred v. Breitwieser, either because Breitwieser was a privy to the original judgment, or because the articles themselves were, by that judgment, freed from the control of that patent, we deem it unnecessary to inquire. We need not stop to consider whether the judgment in the case of Eldred v. Kessler had any other effect than to fix unalterably the rights and duties of the immediate parties to it, for the reason that only the rights and duties of those parties are necessarily in question here. *It may be that the judgment in Eldred* v. *Kessler will not afford Breitwieser, a customer of Kessler, a defense to Eldred's suit against him. Upon that question we express no opinion.* Neither it nor the case in which it is raised are before us. But the question here is whether, by bringing a suit against one of Kessler's customers, Eldred has violated the right of Kessler (pp. 288-289). (Italics supplied.)

Thus for *Kessler* v. *Eldred* to apply, there first must have been a judgment in favor of the manufacturer and then a suit brought by the manufacturer against the patent owner to prevent *further* suits against customers of the manufacturer.

In the case at bar there has not been any judgment of any kind in favor of Metallizing Company of America, and the Ohio suit against the Aberdeen Motor Supply Co. was already pending prior to the decision herein by the Second Circuit Court of Appeals. All that has happened here is that the Metallizing Company of America has defended the present suit by reason of the fact that the Respondents herein purchased from it an unpatented transformer which the Respondents have used in carrying out the *process* of the patent.

The final judgment in this case merely has decided that the Respondents (not the Metallizing Company of America) are free to use the process by reason of the fact that the inventor had made public use thereof for more than one year prior to his application. That holding is wholly independent of whether the Respondents had used a transformer made by the Metallizing Company of America or one constructed by themselves, or one made by any other of the large number of manufacturers of electrical apparatus in this country.

The decision herein does not hold that any one who uses the transformer of the Metallizing Company of America is free from the patent. It does hold that the patent is invalid by reason of the inventor's own public use and that the process can, therefore, be used by the public freely *no matter whose or what transformer is employed.* The right of the defendants in the pending Ohio suit does not depend in any way upon whether they have used the process with a transformer of the Metallizing Company of America or with any one else's transformer.

The issue of whether this Petitioner can continue to harass and annoy and sue for infringement the customers of the Metallizing Company of America, who sell an unpatented transformer, has not been raised. It is only such an issue that was decided by the Court in *Kessler* v. *Eldred.*

When and if that issue is presented as between Metallizing Company of America and Petitioner, it will, however, differ in one important respect from *Kessler* v. *Eldred,* namely, that Petitioner here in addition is attempting by a process patent not only to control but to destroy the business of the Metallizing Company of America in connection with the manufacture and sale of an unpatented piece of apparatus, an ordinary electrical transformer.

Respectfully submitted,

MORRIS KIRSCHSTEIN,
Counsel for Respondents.